SUPREME COURT, U.S.
FILED

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No.

IN THE

Supreme Court of the United States

TYCO HEALTHCARE GROUP LP, MALLINCKRODT INC., LIEBEL-FLARSHEIM COMPANY, AND NEMOTO KYORINDO CO., LTD.

Petitioners,

v.

MEDRAD, INC.,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR WRIT OF CERTIORARI

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QUESTION PRESENTED

Whether the Federal Circuit erred, and destabilized patent law, by effectively abrogating the express statutory limitations on reissuing defective patents set forth in 35 U.S.C. § 251, and thereby permitting such patents to be reissued as a matter of course.

CORPORATE DISCLOSURE STATEMENT

Pursuant to this Court's Rule 29.6, petitioners Tyco Healthcare Group LP, Mallinckrodt Inc., and Liebel-Flarsheim Company hereby state that they are subsidiaries of Tyco International Ltd., a publicly-traded company. No publicly held company owns 10% or more of the stock of Tyco International Ltd.

Petitioner Nemoto Kyorindo Co., Ltd. is a Japanese corporation. No publicly held company owns 10% or more of the stock of Nemoto Kyorindo Co., Ltd.

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INTRODUCTION

The patent reissue statute, 35 U.S.C. § 251, provides expressly when a patent may be reissued to cure a defect. Under the plain language of that statute, a reissue patent is authorized *only* where the original patent was defective either [1] "by reason of a defective specification or drawing," or [2] "by reason of the patentee claiming more or less than he had a right to claim in the patent." But the Court of Appeals for the Federal Circuit now has effectively abrogated these express statutory limitations. According to the Federal Circuit, the holder of a patent suffering from any defect that would render it invalid *invariably* "claim[s] more ... than he had a right to claim in the patent," simply because, by definition, the holder of an invalid patent may not claim any rights in the patent. By thus holding that a reissue patent is authorized for *any* defect, notwithstanding the specific defects authorized for remediation by Congress in the statute, the Federal Circuit not only violated fundamental rules of statutory construction and overturned settled law, but destabilized the patent system by authorizing reissue of defective patents as a matter of course, and far beyond legal authorization.[1]

In particular, the Federal Circuit held in this case that a patentee who made *no changes* to the specification, drawings, claims, or any other part of the patent could nevertheless obtain a reissue patent. The patent at issue here was invalid because the patentee failed to file a required supplemental declaration, as specified in the rules governing the application process. But that ground simply does not fit within the statutory categories, if

---

[1] This is similar to the Federal Circuit's failure to abide the express statutory limits of Rule 50(a) of the Federal Rules of Civil Procedure. *See Unitherm Food Sys., Inc. v. Swift-Eckrich, Inc.*, 546 U.S. 394 (2006).

those categories are to have any meaning. The Federal Circuit concluded otherwise only by relying on "the remedial nature of the statute," and the consequent supposed need to provide a "liberal construction." But such maxims are devices to aid in statutory construction, not excuses to ignore statutory language. If Congress wanted to authorize reissue for *any* defect in a patent, it could and would have done so. It is not the Federal Circuit's proper role to judicially amend the statute to accomplish that result.

The principle of finality is important in patent law, just as in other areas of law. Thus, Congress did not authorize patent reissuance for any reason or as a matter of course, but only for specified defects. Because the Federal Circuit has effectively overruled Congress' policy decision, and no other judicial avenue to correct that error exists, absent review by this Court, this Court should grant the petition and either set the case for review on the merits or summarily reverse the decision below. At a minimum, this Court may wish to call for the views of the Solicitor General on this important question of patent law.

OPINIONS BELOW

The District Court's decision granting petitioners' motion for summary judgment of invalidity of U.S. Patent RE37,602 ("the '602 patent") is reported at 391 F. Supp. 2d 374 (W.D. Pa. 2005) and reprinted in the Appendix ("App.") at 13-28a. The Federal Circuit's decision reversing the District Court's decision is reported at 466 F.3d 1047, and reprinted at App. 1-10a. The Federal Circuit's unpublished order denying petitioners' combined petition for rehearing and rehearing *en banc* is reprinted at App. 11-12a.

JURISDICTION

The Federal Circuit rendered its decision on October 16, 2006, App. 1-10a, and denied a timely combined

petition for rehearing or rehearing *en banc* on January 3, 2007. This Court has jurisdiction under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS AND REGULATIONS INVOLVED

Section 251 of Title 35 of the United States Code provides, in pertinent part:

> Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, *by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent*, the Director shall ... reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

35 U.S.C. § 251 (emphasis added).

Section 1.175(a) of Title 37 the Code of Federal Regulations provides that:

> The reissue oath or declaration in addition to complying with the requirements of § 1.63, must also state that:
>
> (1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and
>
> (2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose

> without any deceptive intention on the part of the applicant.

Section 1.175(b)(1) of Title 37 the Code of Federal Regulations provides that:

> For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant. Any supplemental oath or declaration required by this paragraph must be submitted before allowance and may be submitted:
>
> (i) With any amendment prior to allowance; or
>
> (ii) In order to overcome a rejection under 35 U.S.C. 251 made by the examiner where it is indicated that the submission of a supplemental oath or declaration as required by this paragraph will overcome the rejection.

STATEMENT OF THE CASE

A. Factual Background

Respondent Medrad, Inc. filed an original patent application on November 26, 1993 relating to a mechanical injector for injecting a contrast agent into a patient undergoing a magnetic resonance procedure. That application issued as U.S. Patent No. 5,494,036 ("the '036 patent") on February 27, 1996. Federal Circuit Appendix ("CAFed App.") 454-59.

On February 23, 1998, Medrad filed an application for reissue of the '036 patent and submitted reissue declarations stating that the inventors had claimed less than they had a right to claim (an "underclaiming" error). CAFed App. 470-74. During prosecution of this first reissue application, Medrad corrected the underclaiming

error by adding additional claims. CAFed App. 476-84. Medrad also attempted to correct an alleged "overclaiming" error by narrowing certain claims, and it attempted to correct inventorship by adding two additional inventors to the patent. CAFed App. 488-94, 503-12. Medrad failed, however, to submit supplemental reissue declarations regarding the overclaiming or inventorship errors, as required by 37 C.F.R. § 1.175(b)(1). Despite this failure, the reissue application issued as U.S. Patent No. RE36,648 ("the '648 patent") on April 11, 2000. CAFed App. 228-35.

On April 25, 2000, Medrad filed a complaint with the U.S. International Trade Commission ("the ITC Action") alleging that the Optistar MR contrast delivery system manufactured by petitioner Nemoto Kyorindo Co., Ltd. in Japan and imported and/or sold by petitioner Mallinckrodt Inc. and its subsidiary, Liebel-Flarsheim Company,[2] infringed the '648 patent. CAFed App. 109-14, 134-38, 514-17. On September 26, 2000, the administrative law judge in the ITC Action entered an Initial Determination that the '648 patent was invalid due to Medrad's failure to file the required supplemental declarations regarding the overclaiming and inventorship errors. CAFed App. 237-61. The ITC denied Medrad's petition to review the Initial Determination and terminated the ITC action on February 12, 2001. CAFed App. 526-31.

On November 16, 2000—before the ITC's Initial Determination had become final—Medrad filed a second reissue application, seeking to reissue the '648 patent. CAFed App. 269-79. Medrad's re-reissue patent application was *identical* to the '648 patent. Medrad

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[2] Tyco International, the parent of petitioner Tyco Healthcare LP, acquired Mallinckrodt in 2000.

made no changes to the specification, drawings, claims, or any other part of the '648 patent. Medrad filed the second reissue application for one purpose—to submit supplemental declarations regarding the overclaiming and inventorship errors. CAFed App. 351-72. The re-reissue patent application issued as U.S. Patent No. RE37,602 on March 26, 2002 (the '602 patent"). CAFed App. 149-56.

B. Procedural History

On October 24, 2001, Medrad filed a complaint for patent infringement in the United States District Court for the Western District of Pennsylvania against petitioners Tyco Healthcare Group LP, Mallinckrodt Inc., Liebel-Flarsheim Company, and Nemoto Kyorindo Co., Ltd. (hereinafter collectively "Tyco"). CAFed App. 109-16. Medrad and Tyco thereafter filed cross motions for summary judgment regarding the validity of the '602 patent. CAFed App. 196-561.

Realizing that the "'602 Patent does not change the specification, drawings, claims, or any other part of the '648 Patent," App. 16a, the District Court (Lancaster, J.) stated that the dispositive question was "whether the reissue statute, 35 U.S.C. § 251, can be used to correct a mistake that [Medrad] made during the prosecution of the predecessor patent, *i.e.* failing to file supplemental reissue declarations in compliance with PTO Rule 1.175." App. 17a. The District Court granted Tyco's motion for summary judgment of invalidity based on its interpretation of Section 251:

> Because we find that *section 251 requires that some error in the specification, drawings, or claims of the patent be corrected as a result of the reissue process,* we grant defendants' motion for summary judgment. Although we recognize that the reissue statute is remedial and must be construed broadly, we cannot

> interpret a federal statute in a way that eliminates the very phrases of limitation from its text. Were we to adopt plaintiffs reasoning that a patent holder could secure, by reissue, a patent that is the same in all respects on its face, but corrects a mistake made during the prosecution of a predecessor patent that results in the patent being invalid, we would do just that. Neither the statute, nor the cases interpreting it, justifies such a result.

App. 18a (emphasis added).

Medrad appealed the District Court's decision to the Federal Circuit. In its opening brief, Medrad argued that "[b]y not filing the supplemental declarations, Medrad's inventors thus claimed *less* than they had a right to claim because without the supplemental declarations, the patent was deemed inoperative and invalid and so there were no claims." App. 39a (emphasis added). The Federal Circuit, basing its decision on a different rationale than that presented by Medrad, reversed the District Court's decision, holding in pertinent part that

> by including changes to the language of the claims that narrowed the scope of coverage and by correcting inventorship, the resulting '648 reissue patent claimed *more* than it had a right to claim in the patent without submitting a supplemental declaration to support the narrowing subject matter and the change in inventorship. The correction of such an error [*i.e.*, by submitting a supplemental declaration] meets the express terms of section 251 and thus serves as a basis for reissue.

App. 10a (emphasis added). The Federal Circuit noted that "we do not interpret the disputed language in section 251—'by reason of the patentee claiming more or less than he had a right to claim in the patent'—to require

that the error occur in the actual language of the claims." App. 8a.

Petitioners filed a combined petition for rehearing and rehearing en banc, but the Federal Circuit denied the petition. App. 11-12a. This petition follows.

REASON FOR GRANTING THE WRIT

I. THE FEDERAL CIRCUIT ERRED, AND DESTABILIZED PATENT LAW, BY EFFECTIVELY ABROGATING THE EXPRESS STATUTORY LIMITATIONS ON REISSUING DEFECTIVE PATENTS SET FORTH IN 35 U.S.C. § 251, AND THEREBY PERMITTING SUCH PATENTS TO BE REISSUED AS A MATTER OF COURSE.

A. By Rendering Superfluous the Express Limitations of the Reissue Statute, the Federal Circuit's Decision Conflicts With Supreme Court Precedent Regarding Statutory Interpretation.

The Federal Circuit's decision renders superfluous the express limitations of 35 U.S.C. § 251, thereby conflicting with established Supreme Court precedent regarding statutory interpretation. For more than a century, this Court has taught that statutes should be construed so that "no clause, sentence, or word shall be superfluous, void, or insignificant." *Market Co. v. Hoffman*, 101 U.S. 112, 115-16 (1879) (quoting Bacon's *Abridgement of the Law*, Section 2), *quoted in TRW Inc. v. Andrews*, 534 U.S. 19, 31 (2001) and *Duncan v. Walker*, 533 U.S. 167, 174 (2001))); *see also United States v. Alaska*, 521 U.S. 1, 59 (1997) ("The Court will avoid an interpretation of a statute that 'renders some words altogether redundant.'") (quoting *Gustafson v. Alloyd Co.*, 513 U.S. 561, 574 (1995)); *Pennsylvania Dep't of Pub. Welfare v. Davenport*, 495 U.S. 552, 562 (1990) ("Our cases express a deep reluctance to interpret a statutory provision so as to

render superfluous other provisions in the same enactment."); *South Carolina v. Catawba Indian Tribe*, 476 U.S. 498, 510 n.22 (1986) ("It is an 'elementary canon of construction that a statute should be interpreted so as not to render one part inoperative.'"); *United States v. Menasche*, 348 U.S. 528, 538-39 (1955) ("It is our duty to give effect if possible, to every clause and word of a statute."); *National Labor Relations Bd. v. Jones & Laughlin Steel Corp.*, 301 U.S. 1, 30 (1937) ("The cardinal principle of statutory construction is to save and not to destroy."); *Inhabitants of Montclair Tp. v. Ramsdell*, 107 U.S. 147, 152 (1883) ("It is the duty of the court to give effect, if possible, to every clause and word of a statute....").

In *Colautti v. Franklin*, 439 U.S. 379 (1979), this Court addressed such a statutory construction issue. At issue was Section 5 of the Pennsylvania Abortion Control Act, which required a physician "to observe the prescribed standard of care if he determines 'that the fetus is viable or if there is sufficient reason to believe that the fetus may be viable.'" *Colautti*, 439 U.S. at 392 (quoting Pennsylvania Abortion Control Act, 1974 Pa. Laws, Act No. 209, Pa. Stat. Ann., Tit. 35, § 6605(a) (Purdon 1977)). This Court rejected appellants' argument that "may be viable" is synonymous with "viable," stating that

> [t]he syntax clearly implies that there are two distinct conditions under which the physician must conform to the standard of care. Appellants' argument that "may be viable" is synonymous with "viable" would make either the first or the second condition redundant or largely superfluous, in violation of the elementary canon of construction that a statute should be interpreted so as not to render one part inoperative.

Colautti, 439 U.S. at 392 (quoting *Menasche*, 348 U.S. at 538-539).

This Court faced the issue again in *Duncan v. Walker*, addressing a portion of the Habeas Corpus statute that stated that the time during which an "application for State post-conviction or other collateral review" is pending tolls the limitation period for filing federal habeas petitions. 533 U.S. at 167 (quoting 28 U.S.C. § 2244(d)(2)). This Court rejected respondent's attempt to construe the phrase "State post-conviction or other collateral review" to encompass both state and federal collateral review, noting that under this construction the "word 'State' places no constraint on the class of applications for review that toll the limitation period. The clause instead would have precisely the same content were it to read 'post-conviction or other collateral review.'" *Duncan*, 533 U.S. at 174.

Similarly, in this case, the Federal Circuit's reading of Section 251 renders part of that statute—namely, the express limitations on the right to obtain a reissue patent—superfluous. The express terms of Section 251 limit the patents that can be reissued to those that are invalid or inoperative "by reason of a defective specification or drawing," or those that are invalid or inoperative or "by reason of the patentee claiming more or less than he had a right to claim in the patent." But according to the Federal Circuit, a patentee who simply failed to follow a procedural requirement can also obtain a reissue patent. App. 8-10a. Thus, the Federal Circuit erred by rendering superfluous the express limitations of the patent reissue statute, 35 U.S.C. § 251.

B. The Federal Circuit's Broad Interpretation of the Limitation "By Reason Of The Patentee Claiming More Or Less Than He Had A Right To Claim" Conflicts With Federal Circuit and CCPA Precedent.

The Federal Circuit arrived at its statutory construction by an overly broad interpretation of Section 251's express limitation "by reason of the patentee

claiming more or less than he had a right to claim," stating that "we do not interpret th[is] disputed language in section 251 ... to require that the error occur in the *actual language of the claims*." App. 8a (emphasis added). Based on this interpretation, the Federal Circuit held that the correction of even unspecified procedural errors meets the express terms of Section 251. App. 8-10a. However, the Federal Circuit's interpretation of this express limitation conflicts squarely with numerous statements in earlier Federal Circuit and Court of Customs and Patent Appeals ("CCPA") decisions.

In *In re Handel*, 312 F.2d 943 (C.C.P.A. 1963), for example, the CCPA provided an interpretation directly at odds with the Federal Circuit's recent decision:

> [T]he whole purpose of the statute, so far as claims are concerned, is to permit limitations to be added to claims that are too broad or to be taken from claims that are too narrow. *That is what the statute means in referring to "claiming more or less than he had a right to claim."*

312 F.2d at 948 (emphasis added).

The CCPA applied the same statutory interpretation in an earlier decision in *In re Rogoff*, 261 F.2d 601 (C.C.P.A. 1958):

> [Section 251] provides for the reissue of a patent when it is "deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent." There is no contention here that the specification or drawing of appellant's patent is defective nor that he claims in the patent more than he had a right to claim as new. *The only remaining ground for reissue, therefore, must be that he*

> *claimed less than he had a right to claim as new, but if that were the case, the only appropriate remedy would be a reissue with broadened claims.*

261 F.2d at 605 (emphasis added).

The Federal Circuit itself has adopted this interpretation of the "claiming more or less than he had a right to claim" language of Section 251. In *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 882 F.2d 1556 (Fed. Cir. 1989), the Federal Circuit explained that the expression "less than he had a right to claim" "covers the situation where the claims in the patent are narrower than the prior art would have required the patentee to claim and the patentee seeks broader claims." 882 F.2d at 1564. "Conversely, the alternative that the patentee claimed 'more ... than he had a right to claim' comes into play where a claim is too broad in scope in view of the prior art or specification and the patentee seeks narrower claims." *Id.* at 1565.

The Federal Circuit reiterated this interpretation of the reissue statute in *In re Amos*, 953 F.2d 613 (Fed. Cir. 1991), indicating that there are only four grounds available for reissue under Section 251:

> First, an asserted defect may arise from an error in a specification. Second, the patentee may correct a defective drawing. The final two reasons for which the patentee may seek reissue concern *original claims subsequently discovered to have been either too narrow or too broad.*

953 F.2d at 616 (emphasis added).

Similarly, in *Slip Track Sys., Inc. v. Metal Lite, Inc.*, 159 F.3d 1337 (Fed. Cir. 1998), the Federal Circuit noted that "a reissue application is available to Slip Track only if it can allege that there is an error in the drawings,

specification, *or scope of the claims* of the Brady patent." 159 F.3d at 1341 (emphasis added).

The Federal Circuit upheld Medrad's '602 patent, even though Medrad asserted no error in the specification, drawings, or scope of the claims. In so doing, the Federal Circuit misinterpreted the express statutory limitation "by reason of the patentee claiming more or less than he had a right to claim," deviating from earlier decisions of the Federal Circuit and the CCPA.

C. The Federal Circuit's Decision Improperly Allows Reissue of a Patent in Identical Form to the Original Patent, Conflicting With Federal Circuit and CCPA Precedent.

The Federal Circuit's decision also conflicts with prior Federal Circuit and CCPA decisions that declined to allow the reissue of a patent in identical form to the original patent.

For example, in *In re Dien*, the CCPA noted that "it goes without saying that reissue of a patent in identical form with the original patent is not a possibility." 680 F.2d 151, 153 n.4 (C.C.P.A. 1982). The Federal Circuit reiterated this statement in *In re Clement*, 131 F.3d 1464, 1472 (Fed. Cir. 1997). Yet this is exactly what happened in the instant action—the '602 patent is identical in form with it predecessor patent, the '648 patent.

The legislative history of Section 251 confirms that Congress intended for reissued patents to be changed from the predecessor patents. As the pertinent committee report explained,

> Sections 251 and 252 are a development of the present statute relating to what are called reissues. Under certain circumstances *the patentee may obtain a new patent* to replace the old one to correct certain defects that he may have discovered *in the patent*.

S. Rep. No. 1979, 82nd Cong., 2d Sess. 5 (1952) (emphasis added).

By upholding Medrad's '602 patent, which was identical to the '648 patent, the Federal Circuit ignored this legislative history and earlier Federal Circuit and CCPA decisions.

D. The Federal Circuit's Decision Improperly Allows Re-Prosecution of the Original Patent Application, Conflicting With Federal Circuit Precedent.

The Federal Circuit's decision also improperly allows a patentee to use reissue proceedings to re-prosecute the original patent, conflicting with prior decisions that indicate that this is an impermissible use of the reissue statute.

In *In re Weiler*, for example, the Federal Circuit stated that—although the reissue statute "is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally," 790 F.2d 1576, 1579 (Fed. Cir. 1986)—"the reissue statute was not enacted as a panacea for all patent prosecution problems, nor as a grant to the patentee of a second opportunity to prosecute *de novo* his original application." *Id.* at 1582; *accord In re Serenkin*, Nos. 06-1242, 10/134, 10/550, 2007 WL 656254, at *3 (Fed. Cir. Mar 06, 2007) (declining to allow patentee to use the reissue statute to undo the consequences of his attorney's deliberate choice during original prosecution); *Hewlett-Packard*, 882 F.2d at 1565-66 (finding that factual inaccuracy of affidavits eliminated basis for reissue and rendered certain claims of reissue patent invalid).

Medrad utilized the reissue statute to obtain a second opportunity to prosecute its patent application. In the prosecution of the application leading to the '648 patent, Medrad could and should have submitted supplemental reissue declarations. As Medrad admitted, "had Medrad

filed the requisite supplemental reissue declarations with the '648 patent, Medrad would have perfected its claim to a reissue patent and enjoyed the full scope of patent protection provided by the '648 reissue claims." App. 40a. By applying for reissue of the '648 patent for the sole purpose of adding these declarations, Medrad obtained a second opportunity to prosecute its original application for the identical patent. The Federal Circuit's decision improperly upheld the patent despite this conduct, in conflict with prior Federal Circuit decisions.

CONCLUSION

This Court should grant the petition for writ of certiorari, and either grant plenary review or summarily reverse the decision below.

Respectfully submitted,

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APPENDIX A — OPINION AND ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DATED OCTOBER 16, 2006

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

MEDRAD, INC.,

Plaintiff-Appellant,

v.

TYCO HEALTHCARE GROUP LP, MALLINCKRODT INC., LIEBEL-FLARSHEIM CO., and NEMOTO KYORINDO CO., LTD.

Defendants-Appellees.

No. 06-1082

DECIDED: October 16, 2006

Before: MICHEL, *Chief Judge,* ARCHER, *Senior Circuit Judge,* and LINN, *Circuit Judge.*

Medrad, Inc. appeals from a final judgment granting the motion of Tyco Healthcare Group LP, Mallinckrodt Inc., Liebel-Flarsheim Co., and Nemoto Kyorindo Co., Ltd. (collectively "Tyco") for summary judgment of invalidity of U.S. Reissue Patent No. 37,602 ('602 reissue patent). Medrad, Inc. v. Tyco Healthcare Group, LP, 391 F. Supp. 2d 374 (W.D. Pa. 2005) (Case No. 01-CV-1997).

Because we conclude that the defect that formed the basis for the '602 reissue patent was within the plain meaning of 35 U.S.C. § 251, we reverse and remand.

I. BACKGROUND

The '602 reissue patent relates to patient infusion systems for use with magnetic resonance imaging systems. There are two predecessor patents to the '602 reissue patent, both of which were assigned to Medrad. The first predecessor patent was U.S. Patent No. 5,494,036 ('036 patent), which issued on February 27, 1996. On February 23, 1998, Medrad filed an application for reissue of the '036 patent and submitted reissue declarations stating that the inventors had claimed less than they had a right to claim (an "underclaiming" error). During prosecution of the reissue, Medrad narrowed the scope of various claims (correcting an "overclaiming" error) and corrected inventorship in addition to correcting the underclaiming error. Medrad did not submit supplemental reissue declarations regarding the overclaiming or inventorship errors as required by 37 C.F.R. § 1.175. That reissue application issued as U.S. Reissue Patent No. 36,648 ('648 reissue patent) and is the second predecessor patent to the '602 reissue patent.

On April 25, 2000, Medrad filed a complaint with the U.S. International Trade Commission alleging illegal importation of devices that infringed the '648 reissue patent. On motion for summary judgment, the administrative law judge ("ALJ") initially found that the '648 reissue patent was invalid due to Medrad's failure to file supplemental reissue declarations regarding the overclaiming and inventorship errors that were ultimately corrected during prosecution. The ALJ's initial decision became the final determination of the International Trade Commission, and the investigation was terminated.

Appendix A

Before the ALJ's initial determination became final, Medrad filed an application for reissue of the '648 reissue patent seeking to correct its failure to submit supplemental declarations during prosecution of the '648 reissue patent. That application resulted in the '602 reissue patent, which is the subject of this appeal. The '602 reissue patent and the '648 reissue patent have identical specifications, drawings, and claims; the only difference is that Medrad filed supplemental declarations during prosecution of the '602 reissue patent that allegedly corrected the failure to do so during prosecution of the '648 reissue patent.

On October 24, 2001, Medrad filed a complaint in district court against Tyco alleging infringement of the '602 reissue patent. Medrad and Tyco filed cross motions for summary judgment regarding the validity of the '602 reissue patent. Medrad, 391 F. Supp. 2d at 376. Tyco argued that the reissue was defective under 35 U.S.C. § 251 because it did not correct one of four statutorily identified errors: a defect in the specification, a defect in the drawings, or an error in either claiming too much or too little in the patent. Id. The court construed section 251 as requiring "that some error in the specification, drawings, or claim of the patent be corrected as a result of the reissue process." Id. at 378. Because the error that Medrad corrected was "procedural" and not an error in the specification, drawings, or claims of the '648 reissue patent, the court granted Tyco's motion, denied Medrad's motion, dismissed all other pending motions as moot, and entered final judgment holding the '602 reissue patent invalid. Id. at 382-83.

On appeal, Medrad challenges the district court's interpretation of 35 U.S.C. § 251 and its invalidity finding based on that interpretation. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(1).

II. DISCUSSION

A. Standard of Review

We review a district court's grant of summary judgment of invalidity de novo. Baxter Int'l, Inc. v. COBE Labs., Inc., 88 F.3d 1054, 1058 (Fed. Cir. 1996). Summary judgment is proper only if there are no genuine issues of material fact and the movant is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c); Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 250 (1986). The scope of 35 U.S.C. § 251 is a question of statutory construction that we review without deference. NTP, Inc. v. Research In Motion, Ltd., 418 F.3d 1282, 1314 (Fed. Cir. 2005). "Whether the statutory requirement of 'error' [in section 251] has been met is an issue of law which we review de novo." Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 994 (Fed. Cir. 1993).

B. Analysis

Medrad argues that the district court erred in concluding that 35 U.S.C. § 251 does not extend to reissues based on defects in inventor declarations. Specifically, Medrad argues that section 251 does not require there to be an error in the specification, drawings, or claims of the patent, but rather encompasses any inadvertent error that results in underclaiming or overclaiming. Medrad cites In re Bennett, 766 F.2d 524 (Fed. Cir. 1985), Brenner v. State of Israel, 400 F.2d 789 (D.C. Cir. 1968), Fontijn v. Okamoto, 518 F.2d 610 (C.C.P.A. 1975), and A.F. Stoddard & Co. v. Dann, 564 F.2d 556 (D.C. Cir. 1977), as cases that have interpreted section 251 to include reissues based on errors that were not literally in the specification, drawings, or claims of the patent. Medrad argues that by failing to file supplemental declarations, the '648 reissue patent was

invalid, and thus claimed less than it had a right to claim within the meaning of section 251.

Tyco counters that section 251—though remedial in nature—is expressly limited to correcting defects in the specification, drawings, or claims, and that to allow correction of any defect that results in invalidity would effectively read out those requirements. Tyco distinguishes Bennett, Brenner, Fontijn, and Stoddard and argues that these cases do not support the proposition that section 251 allows for a reissue in which there were no changes made to the specification, drawings, or claims of the underlying patent. Alternatively, Tyco argues that even if a failure to submit supplemental declarations is an error that is correctable under section 251, the district court's decision should be affirmed because the supplemental declarations submitted in the '602 reissue patent do not comply with 37 C.F.R. § 1.175. Medrad replies that Tyco's alternative argument based on 37 C.F.R. § 1.175 was not considered below and thus should not be considered on appeal.

Section 251 sets forth the requirements for obtaining a reissue patent and provides, in relevant part:

> Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

35 U.S.C. § 251 (emphasis added). The parties frame the issue on appeal as whether the highlighted phrase requires that the error occur in the actual language of a patent's claims—as Tyco argues—or refers broadly to errors that result in patent rights with more or less scope than would have been provided but for the error—as Medrad argues.

"In construing a statute . . . we begin by inspecting its language for plain meaning. If the words are unambiguous, no further inquiry is usually required." Camargo Correa Metais, S.A. v. United States, 200 F.3d 771, 773 (Fed. Cir. 1999) (citation omitted). In our interpretation of the statute, we give words their ordinary, contemporary, common meaning unless Congress has indicated otherwise, NTP, 418 F.3d at 1314-15, and "with a view to their place in the overall statutory scheme." Tyler v. Cain, 533 U.S. 656, 662 (2001) (quoting Davis v. Mich. Dept. of Treasury, 489 U.S. 803, 809 (1989)). We note that neither of the parties has directed us to any legislative history that we should consider. However, we have held that "[i]n enacting [section 251], Congress provided a statutory basis for correction of 'error.' The statute is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally." In re Weiler, 790 F.2d 1576, 1579 (Fed. Cir. 1986).

To begin, we note that the cases cited by Medrad are inapposite to the interpretation at issue in this appeal. In Bennett, we held that a patentee could submit a supplemental declaration to support broadening claims in a timely filed reissue application even though two years had passed. 524 F.2d at 526, 528. Unlike the reissue in this case, the reissue application in Bennett was still proceeding when the supplemental declaration was filed, and the error at issue was in the claim language. Id. at 525-26. In Brenner, the Court of Appeals for the District

of Columbia held that the remedial purpose behind section 251 overcame the literal language of 35 U.S.C. § 119[1] and allowed a patentee to obtain priority rights through reissue. 400 F.2d at 791-92. In Fontijn, the Court of Customs and Patent Appeals held that "a reissue application filed for the sole purpose of perfecting a claim to priority does not broaden the scope of the claims of the original patent and is not in contravention of the requirements of section 251 even though filed more than two years after the patent grant." 518 F.2d at 621. Finally, in Stoddard, the Court of Appeals for the District of Columbia—with no meaningful discussion of section 251—permitted a patentee to change the name of the inventor listed on the patent through reissue. 564 F.2d at 567. Other than to emphasize the remedial nature of section 251 and its liberal construction, we do not find these cases to be particularly relevant to the interpretation at issue in this appeal.

We turn next to the highlighted language in section 251. According to the statute, if an error is without deceptive intent, the highlighted language provides for reissue whenever any patent is deemed wholly or partly inoperative or invalid "by reason of the patentee claiming more or less than he had a right to claim in the patent." The plain meaning of that phrase indicates that the error involves rendering a patent wholly or partly invalid by reason of—i.e., because of—claiming more or less than a patentee has a right to claim. Although such an error

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1 The relevant language of section 119 at that time provided that "[n]o application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed in the Patent Office before the patent is granted." 35 U.S.C. § 119(b) (1964) (emphasis added).

may result from the language used in a claim, the express terms of the statute do not refer only to errors in the claim language itself, as Tyco argues. Rather, the highlighted language in section 251 can be read to encompass any error that causes a patentee to claim more or less than he had a right to claim. Given the remedial nature of the statute and with an eye to its liberal construction, see Weiler, 790 F.2d at 1579, we find such a reading to be entirely appropriate. Further, Tyco fails to identify—and we fail to find—any support in section 251, in the statutory scheme, or in the legislative history to indicate that the highlighted phrase should be limited in the manner Tyco argues. Without an express indication from the statute, we are hesitant to adopt further limitations on the type of errors that are correctable under section 251. See Superior Fireplace Co. v. Majestic Prods. Co., 270 F.3d 1358, 1370 (Fed. Cir. 2001) (declining to limit correction of mistakes under 35 U.S.C. § 255 to narrowing corrections "without express indication from the statute"). Accordingly, we do not interpret the disputed language in section 251—"by reason of the patentee claiming more or less than he had a right to claim in the patent"—to require that the error occur in the actual language of the claims.

The reissue regulations, 37 C.F.R. §§ 1.171-179, require an applicant to file an oath or declaration with an application for reissue. The declaration must state that:

> (1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and

> (2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under [37 C.F.R. § 1.175(a)] arose without any deceptive intention on the part of the applicant.

37 C.F.R. § 1.175(a). The regulations further provide that, "[f]or any error corrected, which is not covered by the [original reissue] oath or declaration submitted under [37 C.F.R. § 1.175(a)], applicant must submit a supplemental oath or declaration stating that every such error arose without deceptive intention on the part of the applicant." 37 C.F.R. § 1.175(b)(1). A failure to submit a supplemental declaration, if required, renders a patent invalid. See Nupla Corp. v. IXL Mfg. Co., 114 F.3d 191, 195 (Fed. Cir. 1997) (holding a patent invalid under a previous version of 37 C.F.R. § 1.175, because "when amendments correcting an overclaiming [error] are made during reissue prosecution in response to a rejection, a patentee is obligated to file a supplementary declaration" if that error was not supported by the original declaration).

Here, in the application for reissue that resulted in the '648 reissue patent, preliminary amendments were submitted to add new claims directed solely to the broadened subject matter identified in the inventors' declarations. These amendments were supported by the original reissue declaration. Later amendments, however, narrowed existing claims and corrected inventorship. Because the later amendments were not supported by the original reissue declaration, a supplemental declaration was required under 37 C.F.R. § 1.175; however, none was filed before the '648 reissue patent issued. If the narrowing amendment had never been filed, there would have been no need under the rules to file a supplemental declaration, and the resulting reissue would not have been subject to a validity

challenge for failure to file such supplemental declaration. However, by including changes to the language of the claims that narrowed the scope of coverage and by correcting inventorship, the resulting '648 reissue patent claimed more than it had a right to claim in the patent without submitting a supplemental declaration to support the narrowing subject matter and the change in inventorship. The correction of such an error meets the express terms of section 251, and thus serves as a basis for reissue.

Tyco alternatively argues that we should affirm summary judgment of invalidity because the declarations submitted in the '602 reissue patent do not comply with 37 C.F.R. § 1.175. The district court, however, expressly declined to consider that issue. See Medrad, 391 F. Supp. 2d at 377 n. 2 ("Defendants dispute whether the declarations that were filed during the prosecution of the '602 [reissue patent] actually satisfy the requirement of PTO Rule 1.175. We need not reach that issue, however, given our disposition of these motions."). We think that issue is more appropriately addressed by the district court on remand, and we decline to consider it in the first instance.

III. CONCLUSION

Because we conclude that a defect that formed the basis for the '602 reissue patent was the type of defect that can be corrected under 35 U.S.C. § 251, we reverse the district court's summary judgment that the '602 reissue patent is invalid and remand for further proceedings consistent with this opinion.

REVERSED AND REMANDED.

COSTS

No costs.

APPENDIX B — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DATED JANUARY 3, 2007

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

MEDRAD, INC.,

Plaintiff-Appellant,

v.

TYCO HEALTHCARE GROUP LP, MALLINCKRODT INC., LIEBEL-FLARSHEIM CO., and NEMOTO KYORINDO CO., LTD.

Defendants-Appellees.

No. 06-1082

ORDER

NOTE: This order is nonprecedential.

A combined petition for panel rehearing and for rehearing en banc having been filed by the Appellee, and a response thereto having been invited by the court and filed by the Appellant, and the petition for rehearing and response, having been referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc and response having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for panel rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on January 10, 2007.

FOR THE COURT,

s/ Jan Horbaly
Clerk

Dated: 01/03/2007

APPENDIX C — MEMORANDUM AND ORDER OF THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF PENNSYLVANIA DATED OCTOBER 12, 2005

UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

MEDRAD, INC.,

Plaintiff,

v.

TYCO HEALTHCARE GROUP LP, *et al.*,

Defendants.

No. 01-1997

Before: LANCASTER, GARY L., *District Judge.*

MEMORANDUM

This is an action in patent infringement. Plaintiff, Medrad, Inc., alleges that defendants, Tyco Healthcare Group LP, Mallinckrodt Inc., Liebel-Flarsheim Co., and Nemoto Kyorindo Co., Ltd., have infringed on its patent in violation of the Patent Act, 35 U.S.C. § 271, et seq. The patent asserted in this case, United States Patent No. RE 37,602 (the '602 Patent), discloses and claims inventions relating to patient infusion systems for use with Magnetic Resonance Imaging, or MRI, systems. Plaintiff seeks injunctive and monetary relief.

Before the court are the parties' cross motions for summary judgment regarding the validity of plaintiff's

reissued patent. Defendants filed a motion for summary judgment of invalidity of the '602 Patent based on defective reissue [doc. no. 211]. Defendants argue that under the reissue statute, 35 U.S.C. § 251, a patentee may secure reissue of a patent only to correct one of four statutorily identified errors: a defect in the specification, a defect in the drawings, or an error in either claiming too much or too little in the patent. According to defendants, because plaintiff did not file the reissue application that resulted in the '602 Patent to fix one of these four errors, the '602 Patent is invalid.

Plaintiff also filed a motion for summary judgment of no invalidity based on its filing of the reissue application [doc. no. 216]. Plaintiff argues that a reissue application can be filed to correct any number of mistakes made during the prosecution of a patent. Plaintiff contends that the United States Patent and Trademark Office (the PTO) properly issued the '602 Patent to correct an error caused by a failure to file the appropriate declarations during prosecution of a predecessor patent.

For the reasons set forth below, defendants' motion will be granted and plaintiff's motion will be denied. Because the patent sued upon in this case has been deemed invalid as a result of these rulings, this case will be closed.

BACKGROUND

The facts material to this issue are not in dispute.

There were two predecessor patents to the '602 Patent, both of which plaintiff owned by assignment. First, U.S. Patent No. 5,494,036 (the '036 Patent), issued on February 27, 1996. And second, U.S. Patent No. RE 36,648 (the '648 Patent), issued on April 11, 2000. Plaintiff sought to reissue the '036 Patent to broaden its claims, and filed a reissue declaration regarding that

desired change. During prosecution of the application, however, the PTO actually narrowed plaintiff's claims.[1] In addition, during the prosecution, plaintiff added two more inventors to the patent.

Therefore, while plaintiff originally sought reissue to correct a purported underclaiming error, and filed a reissue declaration regarding that error, the PTO reissued the patent to correct an overclaiming error and an inventorship error. For reasons not clear from the record, plaintiff failed to file a supplemental reissue declaration regarding the two errors identified and ultimately corrected by the PTO, as it was required to do under PTO Rules. 37 C.F.R. § 1.175.

Shortly after the PTO issued the '648 Patent, plaintiff filed a complaint with the U.S. International Trade Commission alleging illegal importation of infringing devices in violation of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337. The Administrative Law Judge found, via summary determination, that the '648 Patent was invalid because plaintiff failed to file supplemental reissue declarations regarding the overclaiming and inventorship errors that were ultimately corrected by the PTO. The ALJ's initial determination became the final determination of the Commission, and the ITC investigation was terminated on February 12, 2001.

Before the ALJ's initial determination became final, plaintiff filed an application with the PTO seeking reissue

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[1] Because reissue is essentially a reprosecution of all claims, original claims that a patentee wants to maintain unchanged may nevertheless be rejected on any statutory ground, or otherwise altered. Hewlett-Packard Co. v. Bausch & Lomb. Inc., 882 F.2d 1556, 1563 (Fed. Cir. 1989) (citing authorities).

of the '648 Patent, which itself was a reissued patent. Plaintiff filed this second reissue application in order to remedy the problems with the '648 Patent that were identified by the ALJ, namely, the lack of supplemental reissue declarations regarding the overclaiming and inventorship errors that were ultimately corrected by the '648 Patent. On March 26, 2002, the PTO issued the '602 Patent, which is the basis of plaintiff's complaint in this case. The '602 Patent does not change the specification, drawings, claims, or any other part of the '648 Patent. The only difference between the two patents is that during the prosecution of the '602 Patent the missing supplemental reissue declarations, identified as lacking by the ITC, were allegedly filed.[2]

STANDARD OF REVIEW

Fed. R. Civ. P. 56(c) provides that summary judgment may be granted if, drawing all inferences in favor of the non-moving party, "the pleadings, depositions, answers to interrogatories and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." To defeat summary judgment, the non-moving party cannot rest on the pleadings, but rather must go beyond the pleadings and present "specific facts showing that there is a genuine issue for trial." Fed. R. Civ. P. 56(e).

The mere existence of some factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment. A dispute over

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[2] Defendants dispute whether the declarations that were filed during the prosecution of the '602 Patent actually satisfy the requirements of PTO Rule 1.175. We need not reach that issue, however, given our disposition of these motions.

those facts that might affect the outcome of the suit under the governing substantive law, i.e. the material facts, however, will preclude the entry of summary judgment. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986). Similarly, summary judgment is improper so long as the dispute over the material facts is genuine. Id. In determining whether the dispute is genuine, the court's function is not to weigh the evidence or to determine the truth of the matter, but only to determine whether the evidence of record is such that a reasonable jury could return a verdict for the non-moving party. Id. at 248-49. Under these standards, the non-moving party must do more than show there is "some metaphysical doubt" as to the material facts. Matsushita Elec. Indus. Co., Ltd. v. Zenith Radio Corp., 475 U.S. 574, 586 (1986).

"Where the record taken as a whole could not lead a rational trier of fact to find for the non-moving party, there is no 'genuine issue for trial.'" Matsushita Elec., 475 U.S. at 587 (citations omitted). In summary, the inquiry under a Rule 56 motion is whether the evidence of record presents a genuine dispute over material facts so as to require submission of the matter to a jury or whether the evidence is so one-sided that the movant must prevail as a matter of law because no reasonable jury could return a verdict in her favor.

DISCUSSION

The dispositive question presented by these cross motions for summary judgment is whether the reissue statute, 35 U.S.C. § 251, can be used to correct a mistake that plaintiff made during the prosecution of the predecessor patent, i.e., failing to file supplemental reissue declarations in compliance with PTO Rule 1.175. Defendants contend that section 251 cannot be used to remedy a procedural mistake made during the prosecution of a predecessor patent. According to

defendants, by statute, errors correctable by reissue are limited to those that remedy a defect found in the specification, drawings, or claims of a patent. Defendants argue that because the '602 Patent makes no change to these parts of the predecessor patent the reissued patent is invalid.

Plaintiff, on the other hand, contends that courts routinely allow patent holders to fix a variety of procedural mistakes and errors made during the prosecution of a patent pursuant to section 251. Plaintiff emphasizes that the statute is remedial in nature and should be construed broadly. According to plaintiff, it proceeded appropriately under section 251 in order to fix the failure to file supplemental reissue declarations during the prosecution of the predecessor patent.

Because we find that section 251 requires that some error in the specification, drawings, or claims of the patent be corrected as a result of the reissue process, we grant defendants' motion for summary judgment. Although we recognize that the reissue statute is remedial and must be construed broadly, we cannot interpret a federal statute in a way that eliminates the very phrases of limitation from its text. Were we to adopt plaintiff's reasoning that a patent holder could secure, by reissue, a patent that is the same in all respects on its face, but corrects a mistake made during the prosecution of a predecessor patent that results in the patent being invalid, we would do just that. Neither the statute, nor the cases interpreting it, justify such a result.

While we recognize that this holding produces a harsh result -- ultimately, plaintiff's patent is invalidated because it failed to file a supplemental declaration with the PTO -- we cannot reconcile plaintiff's legal argument with the language of section 251, and the controlling case law interpreting it. Perhaps the language of section 251

will, or should, change. However, it is not the province of this court to do so.

A. Legal Authority

1. Validity of Patent

A patent, including a reissued patent, is presumed to be valid. 35 U.S.C. § 282; Westvaco Corp. v. Int'l Paper Co., 991 F.2d 735, 745 (Fed. Cir.[3] 1993); Am. Hoist & Derrick Co. v. Sowa & Sons, Inc., 725 F.2d 1350, 1359-60 (Fed. Cir. 1984). Therefore, a successful challenge to the validity of a patent, whether regularly issued, or issued pursuant to re-examination or reissue procedures, must meet the clear and convincing evidence standard. Kaufman Co., Inc. v. Lantech, Inc., 807 F.2d 970, 973-74 (Fed. Cir. 1986).

2. The Reissue Statute

Section 251 of the Patent Act provides for reissue of defective patents. 35 U.S.C. § 251. The section, in pertinent part, states:

> Whenever any patent is, through error without deceptive intention, deemed wholly or partly inoperative or invalid, *by reason of* a defective specification or drawing, or *by reason of* the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent

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[3] The Court of Appeals for the Federal Circuit issues controlling precedent in matters involving patents. 28 U.S.C. § 1295(a).

35 U.S.C. § 251 (emphasis added). By its own terms, section 251 requires that the patentee base his application for reissue upon one of four specified grounds statutorily identified as correctable defects. In re Amos, 953 F.2d 613, 616 (Fed. Cir. 1991). This error requirement limits the availability of reissue to certain correctable errors. Hester Indus., Inc. v. Stein, Inc., 142 F.3d 1472, 1479 (Fed. Cir. 1998). Again, these correctable errors are: (1) a defect in the specification; (2) a defect in the drawings; (3) an error caused by claiming more than one is entitled to (an overclaiming error); or (4) an error caused by claiming less than one is entitled to (an underclaiming error). As such, a reissued patent must result in a change to the specification, drawings, or claims of the predecessor patent. In re Clement, 131 F.3d 1464, 1472 (Fed. Cir. 1997); In re Rogoff, 261 F.2d 601, 605-06 (C.C.P.A.[4] 1958) (finding that there is no statutory basis for reissue where the "new" claims are of the same scope as the claims in the predecessor patent).

The statute is remedial in nature, is based on fundamental principles of equity and fairness, and should be construed liberally. In re Doyle, 293 F.3d 1355, 1358 (Fed. Cir. 2002) (quoting In re Weiler, 790 F.2d 1576, 1579 (Fed. Cir. 1986)). Notwithstanding its remedial nature, the Court of Appeals for the Federal Circuit has stated that section 251 is not a panacea designed to cure every mistake that might be committed by an applicant or his attorney. Id. (quoting In re Orita, 550 F.2d 1277, 1281 (C.C.P.A. 1977)); see also In re Weiler, 790 F.2d at

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[4] The Court of Customs and Patent Appeals is the predecessor to the Court of Appeals for the Federal Circuit, and its decisions are binding precedent in the Federal Circuit. See South Corp. v. United States, 690 F.2d 1368, 1369 (Fed. Cir. 1982).

1579 (stating that "not every event or circumstance that can be labeled 'error' is correctable by reissue").

B. Legal Analysis

The first hurdle that a reissued patent must overcome is whether "a proper ground for reissue existed under section 251." In re Clark, 522 F.2d 623, 625 (C.C.P.A. 1975). A determination of whether a reissue application has met the statutory requirements of section 251 is a question of law. In re Clement, 131 F.3d at 1468. As detailed above, section 251 provides for reissue of a patent that is deemed invalid due to four specific errors: a defect in the specification, a defect in the drawings, an underclaiming error, or an overclaiming error. 35 U.S.C. § 251.

In this case, plaintiff filed a reissue application in order to correct the error in the '648 Patent identified by the ITC, i.e., the lack of supplemental reissue declarations addressed to the overclaiming and inventorship issues ultimately corrected by the PTO. Plaintiff does not contend that this correction fits into one of the four statutorily identified errors. Instead, plaintiff asserts that the Court of Appeals for the Federal Circuit, as well as other courts, have ruled that procedural errors are correctable through reissue, without regard to the identification of a statutorily defined defect. However, the cases on which plaintiff relies do not support that argument.

1. **Court of Appeals for the Federal Circuit Cases**

The cases from the Court of Appeals for the Federal Circuit that plaintiff relies on do not hold that section 251 can be utilized to correct procedural errors made during the prosecution of a predecessor patent, which may affect the ultimate validity of the patent, but have no effect on

the specification, drawings, or claims of the patent itself. Rather, the majority of the cases involve straightforward instances where the reissue statute was used to correct erroneous claims. See In re Doyle, 293 F.3d at 1358; Scripps Clinic & Research Foundations v. Genetech. Inc., 927 F.2d 1565, 1575 (Fed. Cir. 1991); In re Wilder, 736 F.2d 1516, 1518 (Fed. Cir. 1984); Ball Corp. v. United States, 729 F.2d 1429, 1434 (Fed. Cir. 1984).

Even in In re Bennett, 766 F.2d 524 (Fed. Cir. 1985), a case characterized by plaintiff as key to deciding this issue in its favor, the patentee sought reissue in order to change the language of the patent's claims. Bennett, 766 F.2d at 525. The patentee did not file a reissue application in order to correct a "procedural error"; rather, a "procedural error" occurred when the wrong person signed the reissue application. Id. The Court of Appeals for the Federal Circuit approved of the patentee fixing this mistake by filing a supplemental document reflecting the correct signature -- the inventor's. Contrary to plaintiff's contention, the court did not find that the patentee could make that correction by filing a reissue application under section 251.

Instead, the court ruled that section 251 proceedings are not insulated from those provisions of the Patent Act that enable patentees to correct a variety of errors in how documents are signed, and how inventors are listed on documents. In reaching this conclusion, the court pointed out that section 26 of the Patent Act allows for provisional acceptance of defectively executed documents and that sections 116 and 256 provide for amendments to correct errors in inventorship. Id. at 526-28. Admittedly the court also discussed the remedial nature of section 251 and the principles of equity and fairness behind it. Id. at 528. However, the holding in Bennett was that a patentee could, pursuant to other sections of the Patent Act, correct an error in how a reissue application was

executed, and that the correction would "relate back" to the original filing date of the reissue application. Therefore, Bennett is distinguishable from this case, and does not support plaintiff's argument that the Court of Appeals for the Federal Circuit has allowed patentees to use section 251 to fix procedural errors.

We have found no other opinion issued by the Court of Appeals for the Federal Circuit interpreting section 251 in the way plaintiff suggests. Rather, all of the cases addressing this issue identify, as the first step in the analysis, which of the four statutorily identified errors the patentee is seeking to correct under section 251. There are no cases from the Court of Appeals for the Federal Circuit supporting plaintiff's expansive interpretation of section 251.

2. **Other Appellate Court Cases**

Nor do any of the other cases relied upon by plaintiff support that interpretation. Plaintiff relies heavily on Brenner v. State of Israel, 400 F.2d 789 (D.C. Cir. 1968) and A.F. Stoddard & Co., Ltd. v. Dann, 564 F.2d 556 (D.C. Cir. 1977) to support its argument that section 251 can be used to fix procedural prosecution errors. Although these cases do stretch the bounds of section 251 to, and perhaps beyond, its limits, they do not compel the result that plaintiff seeks in this case.

Firstly, these are decisions of the Court of Appeals for the District of Columbia Circuit, not the Court of Appeals for the Federal Circuit, which issues precedential opinions in the realm of patent cases. Secondly, the cases are factually and legally distinguishable from this case.

(a) Brenner v. State of Israel

In Brenner, the patentee filed a reissue application in order to remedy his failure to file a certified copy of the foreign patent under which he claimed priority during

prosecution of the predecessor patent. Brenner, 400 F.2d at 790. The failure to file that patent violated section 119 of the Patent Act, and made the patentee's priority claim ineffective. Id.

The District Court found that the reissue statute was sufficiently broad to entitle the patentee to a reissued patent that included a priority claim based on his foreign patent. Id. at 790. The Court of Appeals for the District of Columbia Circuit affirmed, guided by its obvious belief that the patentee should not loose [sic] his priority rights due to a "trivial clerical error." Id. at 791. However, the court also grounded its ruling in the statutory language of section 251 by equating the loss of an effective priority 'claim' with an underclaiming error. Id. (finding that because the error caused the patentee to lose the benefit of his claim of priority, the "patentee claim[ed] . . . less than he had a right to claim in the patent").

The instant case does not deal with an attempt to fix a "claim" of priority, and is distinguishable on that ground. In addition, Brenner actually emphasizes the importance of making a threshold finding that the reissue application fits within the language of section 251. For these reasons, Brenner is not particularly helpful to plaintiff's argument that section 251 can be used to fix procedural mistakes that fall outside the scope of the four statutorily defined defects.

(b) A.F. Stoddard & Co. v. Dann

We find Stoddard to carry even less weight due to its lack of any meaningful discussion of section 251, its requirements or limitations, or the cases applying it. In Stoddard, the Court of Appeals for the District of Columbia Circuit permitted a patentee to change the name of the inventor listed on the patent under section 251. Stoddard, 564 F.2d at 558. In so doing, the court overruled the Patent Office Board of Appeals's decision

that "section 251, even if most liberally construed, does not authorize the reissuance" of a patent in the name of a different inventor. Id. at 561.

While the Stoddard opinion includes lengthy commentary on the constitutional basis for the patent system, and specifically the role of inventorship in that system, the patent system's requirement of full disclosure, the notion of harmless error, and the inequity of putting form over substance, it remarkably does not include a discussion of whether a proper statutory ground for reissue existed under section 251. The Court of Appeals for the Federal Circuit has instructed that this is the first question that must be answered in determining the validity of a reissued patent. In re Clark, 522 F.2d at 625, In re Wilder, 736 F.2d at 1518. For this reason alone, the Stoddard decision is of questionable value.

In addition, the court's holding was based on an interpretation of another section of the Patent Act, namely section 116, which allows a patent application to be amended to correct a mistake in how joint inventors are listed. 35 U.S.C. § 116. The court found that section 116 could be read as sufficiently expansive to justify the inventorship correction requested by the patentee. Stoddard, 564 F.2d at 567. The court did not substantively discuss section 251 in the opinion at all. In fact, when the court did mentioned [sic] the statute in the conclusion of the opinion, it did so only to point out that the patentee could have obtained the same correction under section 256, but chose to proceed under section 251 instead. Id. at 567 & n.16. This opinion cannot be fairly read to hold that a patentee can use section 251 to fix procedural mistakes in a patent. Therefore, Stoddard does little to advance plaintiff's argument.

Appendix C

3. **Cases Cited in the MPEP**

The cases cited in the Manual of Patent Examining Procedure similarly do not support plaintiff's argument that section 251 can be used to correct procedural errors. Instead, each of the examples listed as a "proper ground" for filing a reissue application result in a change to the specification, drawings, or claims of the patent, which some tribunals have defined to include inventorship or priority "claims" of a patent. See Ex parte Scudder, 169 U.S.P.Q. 814, 815 (B.P.A.I. 1971) (allowing corrections to be made to the named inventor under section 251 because the mistake caused the inventors to "claim" more than, or less than, they had a right to claim); Sampson v. Comm'r. of Patents and Trademarks, 195 U.S.P.Q. 136, 137-38 (D.D.C. 1976) (allowing information to be added to abandoned patent applications in order to perfect a "claim" of priority).

4. **Summary**

In short, none of the cases plaintiff relies on support the contention that section 251 can be used to fix procedural mistakes. Nor do any of the cases support plaintiff's reading of the statute, which eliminates the "by reason of" limitation entirely and allows any error to be fixed as long as it was inadvertent and results in a patent being invalid. Rather, the courts have consistently interpreted section 251 according to its own terms, which require that the mistake sought to be remedied through reissue be one of the four statutorily identified errors. As such, defendants have satisfied their burden to prove, by clear and convincing evidence, that as a matter of law plaintiff's patent is invalid.

While we recognize that the PTO permitted plaintiff to use the reissue procedure to fix its procedural mistake, the PTO is not always correct in its interpretation and application of the reissue statute. See e.g. In re

Hounsfield, 699 F.2d 1320 (Fed. Cir. 1983) (PTO refused reissue due to a lack of intent to claim; Court of Appeals for the Federal Circuit reversed, finding that PTO erroneously viewed lack of intent to claim as precluding reissue); Fontijn v. Okamoto, 518 F.2d 610, 621-23 (C.C.P.A. 1975) (reversing decision of PTO Board of Patent Interferences that perfecting a claim of priority through reissue broadens the claims of a patent).

Although this may produce a harsh result, especially considering that plaintiff filed the second reissue application to remedy a mistake that was apparently acquiesced to by the PTO during the prosecution of the first reissue, it is the result mandated by the statute, as it is currently drafted, and the controlling case law.

CONCLUSION

For the foregoing reasons, defendants' motion for summary judgment is granted, and plaintiff's motion for summary judgment is denied. An appropriate order follows.

Appendix C

ORDER

Therefore, this 12th day of October, 2005, IT IS HEREBY ORDERED that defendants' motion for summary judgment [doc. no. 211] is GRANTED;

IT IS FURTHER ORDERED that plaintiff's motion for summary judgment [doc. no. 216] is DENIED;

IT IS FURTHER ORDERED that all other pending motions are deemed moot, and;

IT IS FURTHER ORDERED that final judgment in this Court is entered pursuant to Rule 58 of the Federal Rules of Civil Procedure and the Clerk of Court is directed to mark this case closed.

BY THE COURT:

s/ Gary L. Lancaster
District Judge

APPENDIX D — OPENING BRIEF OF PLAINTIFF-APPELLANT MEDRAD, INC.

THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

DATED FEBRUARY 13, 2006

UNITED STATES COURT OF APPEALS,
FEDERAL CIRCUIT

MEDRAD, INC.,

Plaintiff-Appellant,

v.

TYCO HEALTHCARE GROUP LP, et al.,
TYCO HEALTHCARE GROUP LP, MALLINCKRODT INC., LIEBEL-FLARSHEIM CO., and NEMOTO KYORINDO CO., LTD.

Defendants-Appellees.

No. 06-1082

Appeal from the United States District Court for the Western District of Pennsylvania in Case No. 01-CV-1997,
Judge Gary L. Lancaster

Appendix D

STATEMENT OF RELATED CASES
(Fed. Circ. R. 47.5)

No other appeal in this proceeding has been before this or any other appellate court. Medrad knows of no cases pending in this or any other court that will directly affect, or be directly affected by, this Court's decision in this appeal.

JURISDICTIONAL STATEMENT

This Court has jurisdiction over Medrad's appeal from the decision of the U.S. District Court for the Western District of Pennsylvania pursuant to 28 U.S.C. § 1295(a)(1). On October 12, 2005, the district court entered a Memorandum and Order granting Defendants' motion for summary judgment of invalidity of the '602 Patent based on defective reissue, denying Medrad's motion for summary judgment of no invalidity based on its filing of a reissue application, deeming all other motions moot, entering final judgment pursuant to Rule 58 of the Federal Rules of Civil Procedure, and closing the case. (JA0001-21).

On October 25, 2005, Medrad moved to alter the judgment under FED. R. CIV. P. 59(e) (JA0023-41), and on October 27, 2005, the district court denied that motion. (JA0043-46). Medrad subsequently filed its timely notice of appeal from the judgment on October 31, 2005. (JA0047-48).

Shortly thereafter, on November 4, 2005, Defendants filed a Motion for Correction of Order Pursuant to FED. R. CIV. P. 60(a) and 60(b)(1), arguing that the district court's order entering final judgment and closing the case was a clerical error because Defendants had an antitrust counterclaim that had not yet been ruled on. (JA0050-61). In fact, on January 18, 2005, the district court had entered an order bifurcating and staying Defendants'

counterclaim. (JA0064-65). On the filing of Defendant's Rule 60 motion, the district court entered a Corrected Order providing that its entry of final judgment and closure were clerical mistakes, which could be corrected under Rule 60 because Medrad's appeal had not been docketed. (JA0022; JA0066-68). Medrad's appeal was not docketed until November 16, 2005. (JA0099-100).

Also on November 16, 2005, Medrad filed a Motion For Entry Of Partial Final Judgment Under FED. R. CIV. P. 54(b), And For An Order Continuing The Stay Of Defendants' Antitrust Counterclaim Pending Appeal. (JA0069-82). After opposition, (JA0083-88), on December 19, 2005, the district court granted Medrad's motion, entered partial final judgment, and continued the stay pending appeal. (JA0090-98). Consistent with the district court's Rule 54(b) determination, this appeal is taken from a final and appealable judgment dismissing Medrad's patent infringement claims.

I. STATEMENT OF THE ISSUE PRESENTED ON APPEAL

In prosecuting a reissue patent under 35 U.S.C. § 251, Medrad erred inadvertently by not filing supplemental declarations executed by the inventors. After an ITC judge invalidated the reissue patent because of that error, Medrad filed a subsequent reissue patent, with appropriate declarations. On summary judgment, the court below held that Medrad's second reissue patent was invalid because the error it corrected did not require a modification of the specification, drawings, or claims of the patent and, therefore, was not within Section 251's scope. This appeal accordingly presents a single, discrete question of law:

(1) Did the district court err as a matter of law in concluding that 35 U.S.C. § 251 is limited to correcting

errors that require actual modification to the specification, drawings or claims of a patent?

II. STATEMENT OF THE CASE

On October 24, 2001, Medrad filed this patent infringement action against Tyco Healthcare, Mallinckrodt and Liebel Flarsheim (collectively "Tyco") in the U.S. District Court for the Western District of Pennsylvania. (JA0109-16). This is the second action regarding these parties and this patented invention.[1]

The first complaints were filed in 2000 at the U.S. International Trade Commission ("ITC"), and in the Western District of Pennsylvania, for infringement of U.S. Patent No. Re 36,648 ("the '648 patent"), which is a reissue of U.S. Patent No. 5,494,036 ("the '036 patent"). After investigation, the ITC determined that the '648 reissue patent was invalid because Medrad had failed to file supplemental inventors' declarations with the U.S. Patent and Trademark Office.[2] (JA0519-24). In view of the ITC's determination, Medrad filed a second reissue application together with inventors' reissue declarations. The named inventors declared that all errors corrected in

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[1] Tyco Healthcare was not a party in the first action because it did not acquire Mallinckrodt until 2001.

[2] The USPTO allowed the '648 reissue patent without requiring Medrad to submit supplemental reissue declarations or noting Medrad's failure to submit the supplemental reissue declarations. 37 C.F.R. 1.175(b)(1) (Oct. 10, 1997) states in pertinent part: "For any error corrected, which is not covered by the [original reissue] oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant."

the second reissue application arose without deceptive intention, and that the '648 patent was partly inoperative because supplemental reissue declarations were not submitted during prosecution of that patent. (*E.g.*, JA0351-54). The USPTO allowed the second reissue --- U.S. Patent No. Re 37,602 ("the '602 patent"), the patent in suit. (JA0101-08).

At the close of discovery in the present action, the parties filed multiple summary judgment motions. Among these were summary judgment motions dealing with whether the '602 reissue patent fell within the scope of 35 U.S.C. § 251. The district court granted Tyco's Section 251 summary judgment motion, denied Medrad's motion, dismissed Medrad's patent infringement claims against Tyco, and held the '602 patent invalid because Section 251 "requires that some error in the specification, drawings or claims of the patent be corrected as a result of the reissue process." *Medrad, Inc. v. Tyco Healthcare Group, LP*, 391 F. Supp. 2d 374, 378 (W.D. Pa. 2005). According to the district court, because Medrad made no changes in the actual language of the claims in its '602 reissue patent application, the USPTO had no authority under the statute to initiate the reissue proceeding and grant the '602 patent. *Id.*

III. STATEMENT OF THE FACTS

A. Medrad's Invention

The '602 patent pertains to vascular injection systems used in connection with magnetic resonance imaging (MRI). (JA0105). MRI technology, introduced into clinical medical practice in the early 1980s, employs magnetic resonance (MR) scanners that utilize magnetic fields to produce high-resolution images of body tissue structure.

Appendix D

Medrad's invention is an electro-mechanical injection system for use in MR procedures. The injector is used to inject a contrast agent into a patient to generate enhanced diagnostic images of the patient's internal organs using MR scanners. The magnetic attraction produced by MR scanners can, however, seriously disturb electronics and bring motors to a stop. At the same time, conventional electronic equipment, such as might be used in an injector, produces "noise" that interferes with the ability of an MR scanner to detect the faint signals that are used to produce images of patients.

To develop an injector for use in MRI procedures, Medrad had to overcome the significant technical problems caused by the strong magnetic fields and highly sensitive signal-detection equipment used in MR scanners. In 1996, Medrad introduced its Spectris® injector, the first injector offered for use in MRI procedures. Medrad's Spectris® injector remained the only MR injector in the U.S. market until Tyco's infringing Optistar injector appeared in January, 2000.

B. The History of Medrad's Patents

The original '036 patent that covered Medrad's invention was filed on November 26, 1993, and issued on February 27, 1996. (JA0454-59). Less than two years later, Medrad requested reissue. This first reissue patent — the '648 reissue patent — issued on April 11, 2000. (JA0461-68). During the examination of the '648 reissue patent, some of the claims in the original '036 patent were canceled, others were amended based on newly considered prior art, and new claims were added that had not been in the original '036 patent.

In December 1999, while the '648 reissue patent was pending in the Patent Office, the infringing Optistar MR injector system received FDA approval by citing the Spectris® injector as a predicate device. Upon

investigation of the Optistar MR injector system, Medrad determined that Optistar infringed many of the claims that would be included in the '648 patent when it issued.

Consequently, shortly after the '648 reissue patent was granted, Medrad filed a complaint with the ITC pursuant to Section 337 of the Tariff Act of 1930. (JA0514-17). During the ITC action, the defendants filed a Motion for Summary Determination (the ITC equivalent of a summary judgment motion) that the '648 reissue patent was invalid on procedural grounds for failure to file a Supplemental Reissue Declaration by the inventors during its examination. (JA0519).

The Patent Office had not requested a Supplemental Reissue Declaration during the '648 reissue patent proceeding, and Medrad had not believed one was necessary. (*E.g.*, JA0352). Administrative Law Judge Luckern, however, decided that (1) the patent statutes required a Supplemental Declaration, (2) the Patent Office could not waive that requirement, and (3) the '648 patent was therefore invalid for purposes of the ITC's jurisdiction. (JA0521-24).

Promptly thereafter, Medrad decided to request reissue from the Patent Office in order to correct the ostensible error before proceeding further. Medrad provided a comprehensive and detailed account of the ITC action and determination to the Patent Office. (File History for Application No. 09/714,907, that resulted in the '602 patent, (hereinafter "the '602 Prosecution History"), JA0305-06). The second reissue patent — the '602 patent-in-suit — filed by Medrad on November 16, 2000, was issued on March 26, 2002, with claims identical to those present in the prior reissued '648 patent. (JA0106-08).

C. The '602 Patent and the Proceedings in the District Court

In the reissue application that resulted in the '602 patent, the inventors stated that they believed that the prior '648 reissue patent was partly inoperative on two grounds. First, they indicated that it was "partly inoperative for lack of a supplemental reissue declaration directed toward the overclaiming error in [claims 9 and 13 of the '036 patent]." (*See, e.g.*, '602 Prosecution History, JA0352). The inventors believed that the "all errors" language in the original reissue declaration covered the overclaiming error. (*See, e.g.*, '602 Prosecution History, JA0352). They further stated that their omission of a supplemental reissue declaration occurred "without any deceptive intention on [their] part." (*See, e.g.*, '602 Prosecution History, JA0351).

Second, the inventors stated that they believed the '648 patent to be "partly inoperative for lack of a supplemental reissue declaration by all of the inventors, in view of the initial determination" of invalidity by ITC Administrative Law Judge Luckern. (*See, e.g.* '602 Prosecution History, JA0352). Thus, as part of the '602 reissue application, the inventors indicated that they "have no disagreement with the inventorship change in [the '648 patent]," that they previously believed that their prior declarations were sufficient, and such error occurred "without any deceptive intention on [their] part." (*See, e.g.*, '602 Prosecution History, JA0351-52).

In its briefing requesting summary judgment on grounds of invalidity, Tyco argued that a reissue application could not be based on any of these grounds. According to Tyco, Section 251 limited errors correctable by reissue to those in the drawings, or in the actual language of the specification or claims themselves. (JA0445-47). Because the reissued '602 patent made no

specific change to the drawings, specification, or claims of the original '648 patent, Tyco contended the reissued '602 patent was invalid. (JA0447-51).

For its part, Medrad argued on summary judgment that courts have approved the use of reissue to correct many errors not pertaining to the drawings or the actual language in the specification or claims. (*See* Medrad, Inc.'s Memorandum in Support of Medrad Inc.'s Motion for Summary Judgment of No Invalidity Based on Medrad's Grounds for Filing the Reissue Application that Resulted in the '602 Reissue Patent (hereinafter "Medrad SJ Brief") at JA0205). Medrad argued that Section 251 is remedial in nature and intended to permit correction of errors in patents for any number of reasons, provided the error occurred without deceptive intent and caused the original patent to be wholly or partly inoperative or invalid. (*See* Medrad SJ Brief at JA0200-01; 0204-09).

Medrad went on to note that the errors corrected in the '602 reissue patent fit within the statutory grounds set forth in Section 251. (*See* Medrad SJ Brief at JA0208; *see also* Transcript of October 6, 2005 Proceedings (hereinafter "*Tr.*") at JA0694-96). Specifically, Medrad argued that it erred by inadvertently failing to file supplemental reissue declarations in the '648 reissue patent, and, as a result, Medrad claimed less than it had a right to claim and did not obtain the full scope of the '648 reissue claims to which it otherwise was statutorily entitled. (*Id.*). Moreover, Medrad argued that the PTO allowed Medrad to reissue the patent, thereby acquiescing in the conclusion that the errors cited by Medrad were properly correctable by reissue under Section 251. (JA0209).

In its October 12, 2005 memorandum decision granting Tyco's motion for summary judgment of invalidity, the district court recognized that the reissue

statute is remedial and must be construed broadly. *Medrad*, 391 F. Supp. 2d at 378. But the district court nonetheless held that:

> [W]e cannot interpret a federal statute in a way that eliminates the very phrases of limitation from its text. Were we to adopt plaintiff's reasoning that a patent holder could secure, by reissue, a patent that is the same in all respects on its face, but corrects a mistake made during the prosecution of a predecessor patent that results in the patent being invalid, we would do just that. Neither the statute, nor the cases interpreting it, justifies such a result.

Id.

The district court then found that Section 251 required that "a reissued patent must result in a change to the specification, drawings, or claims of the predecessor patent." *Id.* at 379. In distinguishing the cases that Medrad relied on, the district court declared that:

> [N]one of the cases plaintiff relies on support the contention that section 251 can be used to fix procedural mistakes. Nor do any of the cases support plaintiff's reading of the statute, which eliminates the 'by reason of' limitation entirely and allows any error to be fixed as long as it was inadvertent and results in the patent being invalid. Rather, the courts have consistently interpreted section 251 according to its own terms, which require that the mistake sought to be remedied through reissue be one of the four statutorily identified errors.

Medrad, 391 F. Supp. 2d at 382. The district court, while recognizing that the PTO permitted Medrad to use the

reissue procedure to fix its "procedural mistake," observed that "the PTO is not always correct in its interpretation and application of the reissue statute." *Id.*

Believing that the district court erroneously had narrowed the scope of Section 251, and thereby had misconstrued the controlling cases, Medrad filed a Motion to Alter Judgment under FED. R. CIV. P. 59(e) (hereinafter "Rule 59(e) Motion"). (JA0023-24). Medrad principally argued in support of its motion that the district court erred in perceiving that the '602 patent was not reissued to correct one of the four statutory errors identified in Section 251. (JA0027-41).

Medrad again emphasized that the '648 patent was deemed to be invalid by the ITC Judge due to an error in the '648 patent prosecution, namely the failure to file supplemental declarations executed by the inventors. (JA0028). By not filing the supplemental declarations, Medrad's inventors thus claimed less than they had a right to claim because without the supplemental declarations, the patent was deemed inoperative and invalid and so there were no claims. (*Id.*). Therefore, the '602 patent was filed "by reason of" the patentees "claiming less than [they] had a right to claim" --- an error squarely within Section 251. (JA0028-29). To support its contention, Medrad highlighted that the "by reason of" language in Section 251 makes no mention, directly or by implication, that any actual changes to the patent's claim language or specification are necessary. (JA0030-32). It also underscored that no case authority required that result either. (JA0034-40)

Without waiting for opposition, on October 26, 2005, the district court denied Medrad's motion. (*See* October 26, 2005 Memorandum Opinion, JA0043-46). The district court again rejected Medrad's construction of Section 251 as it related to the '602 patent in issue, as

well as Medrad's contention that the controlling case law applied Section 251 to a broader class of underclaiming errors than simply those involving the language of the claims. (JA0044-46).

IV. SUMMARY OF ARGUMENT

The court below held that because the error corrected by Medrad in its '602 reissue patent did not require a modification in the actual language of any claim, Medrad's reissue application fell outside the scope of Section 251. Yet, a review of the plain language of Section 251 reveals that it does not endorse the restrictive construction adopted by the court below. Nothing about the statute's remedial purpose mandates such a construction either. Instead, on its face, the statute extends to errors, made without deception, that invalidate a patent and result in a patentee claiming more or less than it was entitled to claim. That language squarely fits Medrad's error here.

Specifically, Medrad erred by inadvertently failing to file supplemental reissue declarations in the '648 reissue patent. The ITC then determined, based on Medrad's error, that the claims of the '648 reissue patent were invalid. Clearly, Medrad's error resulted in its claiming less than it had a right to claim in the '648 reissue patent --- had Medrad filed the requisite supplemental reissue declarations with the '648 reissue patent, Medrad would have perfected its claim to a reissue patent and enjoyed the full scope of patent protection provided by the '648 reissue claims. Medrad then corrected that claiming error under Section 251 through the '602 reissue patent.

Nothing in the language of Section 251 itself forecloses the filing of a supplemental declaration as the basis for reissue. On the contrary, the "by reason of" language in Section 251 makes *no mention*, directly or by implication,

that any actual changes to the patent's claim language or specification are necessary.

In this case, therefore, the district court erred as a matter of law in making an unduly restrictive construction of Section 251 and invalidating Medrad's '602 reissue patent on that basis. The district court's construction is at odds with the statute's plain language and avowed purpose. It should be rejected by this Court.

V. ARGUMENT

The district court's grant of summary judgment below rested solely on its construction of Section 251. No resolution of any disputed facts was involved. The "[i]nterpretation of statutes governing the grant of summary judgment present threshold questions of law that are reviewed *de novo*." *Superior Fireplace Co v. Majestic Prods. Co.*, 270 F.3d 1358, 1366 (Fed. Cir. 2001) (citations omitted).

The ruling below is no exception: the question of whether Medrad's '602 reissue patent falls within the authority of 35 U.S.C. § 251 presents a question of law, which this Court reviews *de novo*. *See In re Clement*, 131 F.3d 1464, 1468 (Fed. Cir. 1997) ("Determining whether an applicant has met the statutory requirements of 35 U.S.C. § 251 is a question of law, which we review *de novo*.") (citations omitted.); *e.g.*, *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 1370 (Fed. Cir. 2001) (construing § 251) (same).

Appendix D

A. Section 251 Extends To The Correction Of Any Error, Made Without Deceptive Intention, That Renders A Patent Wholly Or Partly Invalid By Reason Of A Patentee Claiming more Or Less Than A Patentee Had The Right To Claim

1. The Plain Language Of Section 251 Extends Without Limitation To Any Inadvertent Errors That Meet Its Statutory Prerequisites

Section 251 provides a remedy to patentees whose inadvertent, statutorily defined errors in prosecution result in their patents being wholly or partially invalid. The statute is intended to provide the kind of relief traditionally available in courts of equity to remedy accidental mistake. "In enacting the statute, Congress provided a statutory basis for correction of 'error.' The statute is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally." *In re Weiler*, 790 F.2d 1576, 1579 (Fed. Cir. 1986) (citations omitted); *accord In re Doyle*, 293 F.3d 1355, 1358 (Fed. Cir. 2002) (quoting *In re Weiler*).

Consistent with its remedial purpose, Section 251 in pertinent part reads:

> Whenever any patent is through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new

> matter shall be introduced into the application for reissue.

To be sure, Section 251, by its terms, does not extend to all alleged errors occurring during prosecution. Errors not resulting from accident or mistake, for example, cannot be corrected. *See In re Clement*, 131 F.3d at 1468 (discussing alleged attorney error and stating that "deliberate withdrawal or amendment... cannot be said to involve the inadvertence or mistake contemplated by 35 U.S.C. § 251.") (citation omitted). But, "[w]hen the statutory requirements are met, reissuance of the patent is not discretionary with the Commissioner; it is mandatory ('shall')." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1575 (Fed. Cir. 1991).

In that regard, errors correctable under Section 251 must meet only three basic prerequisites:

> (1) the error must have been made without deceptive intention;[3]
>
> (2) the error must result in the patent being deemed wholly or partly invalid or inoperative; and
>
> (3) the invalidity or inoperability must occur "by reason of" a defective specification or drawing or the patentee claiming more or less than it had a right to claim in the patent.

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[3] An error made "without deceptive intention" is one made by "inadvertence, accident, or mistake," as was true under the prior statutory language in 35 U.S.C. § 64 (1946). *See In re Weiler*, 790 F.2d at 1582; *accord Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 882 F.2d 1556, 1563 (Fed. Cir. 1989).

Congress could have injected further limitations into the reissuance process, but it did not. This Court, in construing Section 251, accordingly must be guided by the policy choice that Congress made in defining the elements to be met for the right to reissuance of a patent. *See In re Doyle*, 293 F.3d at 1363. Section 251 must be interpreted in keeping with its plain meaning. *See NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1314-15 (Fed. Cir. 2005) ("In our interpretation of the statute, we 'give the words of a statute their ordinary, contemporary, common meaning, absent an indication Congress intended them to bear some different import.'") (quoting *Williams v. Taylor*, 529 U.S. 420, 431 (2000)). This Court likewise should refrain from reading any limitations into Section 251 not apparent from the statute itself. *See Superior Fireplace*, 270 F.3d at 1370 (refusing to import limitation into 35 U.S.C. § 255 that would preclude broadening corrections of clerical and typographical mistakes because the words of the statute imposed no such limitation); *see also Eolas Techs. Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1340 (Fed. Cir. 2005) (refusing to read a limitation into 35 U.S.C. § 271(f) and emphasizing that "[i]f the statute intended to limit the reach of 'components of patented inventions,' it would have expressly included some narrowing restriction.").

These principles of statutory construction have direct relevance in considering the application of Section 251 in this case.

First, as far as the category of errors that may be corrected under Section 251, the section extends to *an error* in overclaiming or underclaiming so long as it is made inadvertently and results in the patent being wholly or partially invalid. There is *no requirement*, apart from inadvertence, that limits how or why underclaiming or overclaiming may have occurred. The statute thus encompasses errors of law, errors in drafting,

attorney errors, inventor errors, procedural errors, technical errors, errors of substance, errors of form, or any other type of inadvertent error that gives rise to the need for correction. *See Scripps Clinic & Research Foundation*, 927 F.2d at 1574-75 (reissue statute extends to any category of errors that meet the statutory requirements). Any attempt to read the statute more narrowly is not faithful to its plain language or Congress's policy choice in determining the statute's remedial scope. This construction is also in keeping with the well-accepted notion that the reissue statute is remedial in nature, based on principles of equity, and should be construed liberally. *See In re Doyle*, 293 F.2d at 1358; *In re Willingham*, 282 F.2d 353, 354-55 (C.C.P.A. 1960).

Second, Section 251's error correction function likewise extends, *without limitation*, to any type of invalidity or impairment in which the patent is wholly or partly inoperative, and which occurs by reason of the patentee claiming more or less than it had a right to claim in the patent. If an inadvertent over or underclaiming error results in the scope of the claims not being what they should be, Section 251 presumptively is available to address the problem. Once again, any effort to read this language more narrowly would be at odds with express Congressional intent.

2. Consistent With Congressional Intention, Controlling And Relevant Case Law Provides That Section 251's Plain Language Should Be Broadly Construed To Accomplish Its Error Correction Function

Given its remedial purpose and function, it perhaps comes as no surprise that Section 251 has received a suitably broad construction. Of course, where the facts show an alleged "error" that does not satisfy the statutory

requisites, there is no hesitancy in rejecting a reissue application. But where the statutory requisites are satisfied, there likewise is no hesitancy in bringing reissue patents within the statute's terms.

This Court's *en banc* decision in *In re Bennett*, 766 F.2d 524 (Fed. Cir. 1985), is illustrative and, as shown more fully below, the facts of *Bennett* are very similar to those in the present case. In *Bennett*, the patentee failed to file a correct reissue declaration, with an inventor's signature, in a timely manner. *Id.* At 524-25. Without it, the patentee could not perfect its right to reissue. The question before the Court was whether that failure was correctable under Section 251 ---"the sole question . . . whether the defective execution of the timely filed reissue application may be corrected . . ." *In re Bennett*, 766 F.2d at 526. This Court approved of the patentee fixing this mistake by filing a supplemental document [reissue declaration] reflecting the inventor's correct signature. *Id* at 528. While in *Bennett* the correct declaration was filed during the pendency of the reissue application, the decision plainly shows that a reissue is available to correct a broad scope of errors. As in the present case, in *Bennett* the patent specification, claims, and drawings were not changed by the filing of the correct declaration.

Similarly, in *Brenner v. State of Israel*, 400 F.2d 789, 791 (D.C. Cir. 1968), the Court of Appeals held that the error of failing to file a certified copy of the foreign application upon which the inventor sought priority was correctable under Section 251. The Court succinctly summarized how the failure to file the certified copy fit within the statute as underclaiming error:

> The plain meaning of this section would seem to cover this situation. The patent issued was partly inoperative (insofar as it did not include

> the priority right), and the patentee . . . **did claim less than he had a right to claim.**

Brenner, 400 F.2d at 791 (emphasis added).

The Court of Customs and Patent Appeals ("CCPA") endorsed the holding of *Brenner* -- that reissue is available to correct errors such as the failure to perfect a priority right where no changes to the patent claims are involved -- in *Fontijn v. Okamoto*, 518 F.2d 610 (C.C.P.A. 1975). The question in *Fontijn* was whether a reissue application filed for "the sole purpose of perfecting a claim to priority" was a broadening reissue that had to be filed within two years of the patent for which reissue was sought. *Id.* at 621. The CCPA ruled that the reissue was proper, and did not have to be filed within two years, reversing the Board of Patent Interferences. *Id.* In reaching its decision, the CCPA adopted and applied the holding in *Brenner* that the language in Section 251 regarding "claiming more or less than he had a right to claim in the patent" encompassed errors other than just errors in the actual language of the patent claims. *Id.* at 622.

The CCPA recognized that "claiming" in the first paragraph of Section 251 at issue here ("claiming more or less than he had a right to claim in the patent") has a different meaning from "claims" in the last paragraph of Section 251 ("enlarging the scope of the claims"), which is not at issue here.[4] *Id.* The CCPA found that the passage "enlarging the scope of the claims" (the part of Section

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[4] The language in the last paragraph of Section 251 "enlarging the scope of the claims" relates to the requirement that reissue must be applied for within two years of the issue date of the underlying patent if the actual claim language is broadened.

251 not at issue here) is limited to the wording of the patent claims themselves, and does not apply to reissue based on other types of underclaiming errors like here. *Id.* However, the CCPA's decision confirms that "claiming more or less than he had a right to claim" (the part of Section 251 at issue here) *includes* errors that do not involve actual changes to the words of the patent claims.

In *A.F. Stoddard & Co. v. Dann*, 564 F.2d 556, 567 (D.C. Cir. 1977), the Court of Appeals likewise allowed the correction of both an issued patent and a pending application that had mistakenly been executed by a representative of the assignee instead of the actual inventor. As a result of the inventor's failure to execute the application, the inventor did not perfect his right to the patent claims. *Id.* at 558-59. In that case, the inventor and the assignee sought to correct their error in the issued patent by filing a reissue application under Section 251 and a declaration to the effect that an innocent error had been made, much as Medrad did here. *Id.* As in the present case, the patent specification, claims and drawings were not changed. The Court, reversing the Patent Office, held that Section 251 permitted the correction of an inventorship error not involving a change in the wording of the patent claims:

> The constitutional objectives sought by the patent laws would be best served by a reading of 35 U.S.C. § 116 sufficiently expansive to justify the correction sought in the instant continuation application. *The same correction for the same reason, can with respect to U.S. Patent No. 3,691,069 be effected by means of the instant reissue application filed under the remedial reissue provision*, 35 U.S.C. § 251; *A.F. Stoddard & Co.*, 564 F.2d. at 567 (citation omitted) (emphasis added).

Id. at 567.

In re Bennett, Brenner, Fontijn and *A.F. Stoddard* are representative of a consistent line of authority reading Section 251 according to its plain terms and applying it to inadvertent errors beyond those involving the wording of the patent claims themselves.[5] The reasoning in these cases is in full harmony with Section 251, which makes no mention, as noted above, of any requirement that correction of an inadvertent error must involve modifying or changing actual claim language.

This is not to say that cases decided under Section 251 do not focus on changes or modifications in claim terms. As the district court's opinion reveals, such changes or modifications frequently are under scrutiny in cases involving Section 251, particularly when the so-called

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[5] *See St. Regis Paper Co. v. Bemis Co., Inc.*, 403 F. Supp. 776, 786-87 (D.C. Ill. 1975), *rev'd on other grounds by* 549 F.2d 833 (7th Cir. 1977), *cert. den'd* by 434 U.S. 833 (1977) (the court permitted reissue to correct inventorship and to insert a "continuation-in-part" reference which entitled the plaintiff to an earlier effective filing date, stating: "[j]ustice and reason support the result reached in *Brenner*, that reissue for the correction of 'claims' is not limited solely to the claims of invention. ... It encompasses, as well, *all claims of rights and priority* to which the patentee would have been entitled had there not been inadvertent omission in his original application.") (emphasis added)); *Sticker Indus. Supply Corp. v. Blaw-Knox Co.*, 321 F. Supp. 876, 878-80 (N.D. Ill. 1970) (the court permitted reissue to correct an omission in cross-referencing and a claim of priority, adopting the reasoning of *Brenner*); *Ex parte Scudder*, 169 USPQ 814, 815 (Pat. Off. Bd. App. 1971) ("It is our opinion that the reference in Section 251 to "claiming more or less than he had a right to claim in the patent" cannot be restricted to the patentability of the claims over the prior art.... In this case the joint inventors would be claiming more than they had a right to by asserting that they were the inventors of the subject matter which was invented by only one of them and vice versa.").

"recapture rule" is in play.[6] But even in these cases, the result is *not dictated* by whether there is a change or modification in claim terms. Rather, the resolution turns on *why* the "error" was made – *i.e.*, was it made "without deceptive intention" – because that inadvertence requirement, not a change in claim terms, is the one specified in Section 251. *See Hester Indus., Inc.*, 142 F.3d at 1480 (change in claim terms violated recapture rule and therefore not made inadvertently as contemplated by Section 251); *In re Clement*, 131 F.3d at 1472 (affirming the rejection of the reissue application for the broadened reissue claims for violation of the recapture rule).

The same goes for other attempts to change claim language without any showing of inadvertence, *see, e.g., In re Rogoff*, 261 F.2d 601, 604-6 (C.C.P.A. 1958) (holding that the inventor's sole basis for reissue being the change in the claim language, there was no error that caused the inventor to claim less than he had a right to claim in the original patent), including when that relevant language has been knowingly withheld. *See, e.g., In re Clark*, 522 F.2d 623, 627 (C.C.P.A. 1975) (Section 251 does not extend to re-prosecution "in which the examiner is now given an opportunity to pass on patentability in light of a very pertinent reference which the applicant knowingly withheld from him. We cannot equate this with 'error,' or with 'inadvertence, accident, or mistake.'").

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[6] The recapture rule prevents a patentee from recapturing through reissue any claim or scope of any claim which he willingly surrendered to obtain the original patent. "The rule is rooted in the 'error' requirement in that such surrender is not the type of correctable 'error' contemplated by the reissue statute. [*See Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995 (Fed. Cir. 1993).]" *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 1480 (Fed. Cir. 1998).

None of these cases, or any others cited by the court below, hold that in order for an inadvertent error to support a reissue patent, the error must involve a modification or change in the actual wording of patent claims. Indeed, no reported decision of which Medrad is aware rests on the proposition that because a reissue application did not change or modify the actual wording of the claims, an attempt at error correction fell outside of Section 251's purview. Nor could the propriety of a reissue application be determined on that basis. Such a proposition would be inconsistent with the language of Section 251, which nowhere limits the category of inadvertent errors to those requiring a modification or change in the actual wording of the claims.

B. Medrad's Correction Of The Faulty Reissue Declarations Falls Squarely Within The Plain Language And Express Purpose Of Section 251

The reissue application Medrad made here meets all the prerequisites of Section 251. The '602 reissue patent was filed "by reason of" the patentees "claiming less than [they] had a right to claim" — an error squarely within Section 251.

Looking at the statute's first prerequisite --- an error made without deceptive intention --- the record shows that Medrad was not aware of the alleged problems concerning the declaration filed with the '648 patent and believed that the patent was properly issued, until the ITC Administrative Law Judge made his ruling in 2000. (*E.g.*, Reissue Declaration, JA0352). At that time, however, the prosecution of the '648 reissue patent *was closed* and a supplemental declaration *could not* be filed in the '648 reissue patent. Therefore, Medrad initiated the '602 reissue patent to correct the error. This type of inadvertent error, made without deception, fits precisely within the class of errors addressed by Section 251.

Turning to the second prerequisite --- the error must result in the patent being deemed wholly or partially invalid --- there is no dispute that Medrad's reissue '648 patent was held "invalid" by the ITC Judge due to the failure to file supplemental declarations executed by the inventors. (JA0438-39). This prerequisite too is satisfied on the record here.

And finally, looking to the third prerequisite --- the invalidity must occur "by reason of" the patentee claiming more or less than it had the right to claim in the patent --- by not filing the supplemental declarations, Medrad's inventors, of necessity, claimed "less than [they] had a right to claim." The declarations would have provided the necessary predicate for the right to a reissue patent, and absent the declarations, the patent was deemed "inoperative" and "invalid," and Medrad was deprived of its patent.

Just as failing to file a certified copy of a foreign patent document caused a failure to perfect a priority right in the *Brenner* case, Medrad's failure to file the supplemental declarations resulted in a failure to perfect its right to the '648 reissue patent. Likewise, Medrad's error is of the same type as the failure to perfect priority in *Fontijn*, and the inventorship errors in *Stoddard*, *St. Regis*, and *Scudder*. Just as in these cases, Medrad's error was correctable under Section 251, and the '602 patent was properly granted.

In re Bennett is also directly analogous. The difference between *In re Bennett* and the instant case is timing – in both cases the patentees did not properly file reissue declarations which were required to perfect the right to a reissue patent. The patentee in *In re Bennett* realized its mistake during the prosecution of the reissue application (when the Patent Office informed the patentee of the mistake), while Medrad only realized its mistake

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after the '648 (first) reissue application had issued and the file was closed. The following chart illustrates the comparison:

Issue	Bennett	Medrad
Error in original patent	Claiming less than had right to claim	Claiming more and less than had right to claim.
Correction of error	Adding new claims.	Adding new claims, adding names of inventors, canceling claims and amending other claims of original patent.
Error during reissue	Inventor failed to file declaration required by Section 251.	Inventors failed to file supplemental declaration required by PTO regulations.
PTO action	PTO rejected reissue application because of error made during reissue.	PTO allowed reissue as '648 patent. ITC then determined '648 reissue patent invalid because of error
Error correction	Filed inventor's declaration out of time (statute required filing within two years of the original patent).	Filed inventors' (supplemental) declarations in second reissue.
PTO action	Examiner accepted declaration but rejected reissue application on prior art grounds; PTO Board of Appeals reversed on prior art grounds, but rejected application on the ground that failing to file declaration	PTO allowed reissue as '602 patent.

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Issue	Bennett	Medrad
	timely was not an error correctable by reissue proceeding	
Court review	Federal Circuit reversed, allowing the filing out of time of inventor's declaration to correct filing error.	District Court Invalidated '602 patent, appeal pending at Federal Circuit.

If the patentee in *In re Bennett* had not realized its error until after the reissue prosecution had closed and had to correct its failure to submit a declaration in a second reissue, as Medrad did, this Court would have reached the same result and allowed correction of the error by a second reissue application.[7] That is so because there is no limit in Section 251 on how many times a patentee can avail itself of the process.

And, in this case, just as in *In re Bennett*, there is no apparent reason why the statutory language would not apply to invalidity resulting from the failure to supply a proper inventor declaration. While that may be labeled a "procedural" or "technical" error, as it was by the court below, Section 251 does not exclude such errors from its scope. Further, by reason of that error, Medrad did claim less than it had a right to, effectively claiming nothing at all. There is nothing in the language of Section 251, however, excluding that "less than" result either.

Nor is there any reason for Congress to have carved out such an error from those correctable by the remedial

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[7] In *Bennett* "the sole question [was] whether the defective execution of the timely filed reissue application may be corrected . . ." 766 F.2d at 526.

reissue statute, much less for courts to create such a limitation, given the historic underpinnings of the reissue statute. The propriety of reissue derives from the patentee having fulfilled the patent system's disclosure function in its original application. That original application sets forth, albeit imperfectly, the patentee's right to a valuable invention --- a right that should not be lost through inadvertent error of this type. Here, Medrad publicly disclosed and claimed its invention, albeit imperfectly, because it inadvertently failed to file the appropriate inventor declaration resulting in the invalidity of its claims. Having made the requisite disclosure, it should be permitted to secure its rights.

Any doubt on the issue, and given the plain language of the statute and the controlling case law there should be none, should be resolved in Medrad's favor given the avowed remedial purpose of the statute. Section 251 should be broadly construed in pursuit of its error correction function so that valuable patent rights are not forfeited by technicalities. It would belie the statute's equitable heritage to have Medrad forfeit its patent rights on the technical error involved here.

C. The District Court Erred In Limiting The Scope Of Section 251 To Errors Requiring Modification Or Change To The Actual Language Of A Claim

Although the statute does not so provide and the cases do not require it, the district court held that the only errors cognizable under Section 251 are those correctable by making a modification, or change, to the actual language of the specification, drawing or claims. Consequently, the district court interpreted Section 251 to require that some error in the specification, drawings or claims of the patent be corrected by a change in the specification, drawings or claims as a result of the reissue process. No principle of statutory construction supports

the district court's narrowing limitation and it cannot be squared with the statute's remedial purpose either.

As far as statutory construction principles are concerned, the district court's interpretation takes the statutory language "the patentee claiming more or less than he had a right to claim in the patent" and adds an additional element – the error had to be in the actual language of the claim itself. Yet, as this Court has held in construing an analogous error correction statute, it is not up to courts to insert restrictions or limitations absent from the statute's plain terms:

> Although § 255 . . . does not expressly deal with broadening corrections, the words of § 255 do not preclude broadening corrections. We are hesitant to impose so great a limitation without express indication from the statute. Accordingly, we interpret § 255 to allow broadening corrections of clerical or typographical mistakes.

Superior Fireplace, 270 F.3d at 1370.

This analysis applies with particular force to statutes that serve a remedial purpose. In such statutes, Congress has made a policy choice to support an error correction function and the courts should adhere to that policy choice, not constrain it. There is, moreover, every indication in the language of the statute, its history, and the cases construing it, that courts should strive to bring errors within its scope to avoid forfeitures.

In reaching its erroneous construction of Section 251, the district court largely dismissed Medrad's cited cases as failing to rigorously apply Section 251's statutory prerequisites and construing too broadly the class of underclaiming errors that could be corrected. *Medrad, Inc.*, 391 F.Supp.2d at 379-82. But once again, controlling

legal principles compel rejection of the district court's approach to the cited cases for a number of reasons. To begin with, whatever the district court's views on the rigors of their reasoning, *stare decisis* compelled the following of these authorities, not their outright rejection. More fundamentally, however, the district court dismissed these cases largely on an erroneous premise --- that Section 251 extends only to drafting errors that require a change in the language of the claims, specifications or drawings, and not other errors. Yet, as noted above, that distinction appears nowhere on the face of the statute. Further, had the district court taken the words of the statute at face value, it would have adopted a construction consistent with the cited cases which interpreted Section 251 free of the more restrictive --- but nonexistent --- limitation that a "drafting error" requiring a change in actual claim language exists.

The district court may have felt the need for a "drafting error" limitation to prevent what it otherwise perceived would be the unbridled extension of Section 251 to any type of prosecution error. This concern, too, strays from the mark. Section 251 provides its own set of limits in the statutory prerequisites set forth. These limits are, as this Court's jurisprudence plainly reflects, significant constraints on the category of errors that can be considered. If further constraints are needed, that is up to Congress, not the courts. In the meantime, the statute should be construed as written and properly extended to the inadvertent error Medrad made here.

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VI. CONCLUSION AND DIRECTIONS ON REMAND

The district court erroneously denied to Medrad the equitable relief afforded by Section 251. This Court should reverse the decision below and affirmatively declare that Section 251 extends to inadvertent errors made in this case. Medrad accordingly requests that this Court: (1) reverse the grant of summary judgment in favor of Tyco; and (2) direct the district court to enter a new and different order granting Medrad's cross motion for summary judgment that the '602 reissue patent falls within the scope of Section 251 and was validly reissued.

Respectfully submitted,

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In The

Supreme Court of the United States

TYCO HEALTHCARE GROUP LP, MALLINCKRODT, INC., LIEBEL-FLARSHEIM COMPANY, AND NEMOTO KYORINDO CO., LTD.,

Petitioners,

v.

MEDRAD, INC.,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

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QUESTION PRESENTED

Whether the Federal Circuit properly allowed reissue of a patent in accord with the plain language of the reissue statute, 35 U.S.C. § 251, well-settled precedent, and current Patent Office practice.

DISCLOSURE STATEMENT

Medrad, Inc. is wholly-owned by Schering Berlin Inc., which is wholly-owned by Bayer Gesellschaft fuer Beteiligungen mbH (Bayer G.f.B. mbH), which is wholly-owned by Bayer AG.

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35 U.S.C. § 251 ..... *passim*

Manual of Patent Examining Procedure § 1402 (8th ed. August 2001, revised August 2006) 3, 18

INTRODUCTION

The Petition presents no compelling reason supporting an exercise of this Court's jurisdiction. The Federal Circuit interpreted and applied the express limitations in the patent reissue statute, 35 U.S.C. § 251, consistent with existing precedent and in conformity with established Patent Office practice. A decision that comports with the express language of a statute, published precedent, and administrative practice does not warrant intervention by this Court.

In an effort to prove otherwise, Petitioners fashion a self-created parade of horribles allegedly flowing from the decision below. But they do so based on a series of mistaken premises that bear no resemblance to what was actually decided. For example, they contend that the decision below erroneously determined that Section 251 allows the correction of "any" defect identified in the patent, thereby departing from the statute's purported requirement that a reissue is warranted only when there has been a change in the actual language in the patent. Based on this purported mistake in construction, Petitioners argue that the decision allows reissue to be used to correct purely "procedural" errors, something Petitioners again identify as at odds with Section 251's terms. These two supposed errors then are said to be in glaring conflict with controlling Federal Circuit precedents such that they unravel the existing constraints on the reissue process to the detriment of the patent system.

Yet, when the realities of this case and the decision below are put in proper perspective, there is no parade and there are no horribles. To begin with, the decision below provides for the correction of an error falling within

Section 251's plain language – that is, an error made without deceptive intent that arose by reason of a patentee claiming more or less than it had a right to claim. This is not "any defect," as Petitioners would have it, but rather the specific type of error Congress expressly brought within reissue. Further, the Federal Circuit correctly concluded that Section 251 does not expressly require a change in the actual language of the patent's claims. No such limitation or distinction appears in the section. Nor does Section 251 provide for the exclusion of "procedural," as opposed to "non-procedural," errors. Finally, as the Federal Circuit's reasoning reveals, the decision below generated no conflict with any of its precedents. The denial of rehearing *en banc* regarding the court's narrow holding makes that plain as well.

Petitioners' hyperbolic assertions that the decision below will destabilize the patent process are misguided. Reissue in itself is rare, as less than 40,000 patents out of the over 7 million patents that have been issued have ever been reissued. Ever rarer still, this case involves a reissue patent that has itself been reissued. No other reported case has dealt with that fact pattern, and the Federal Circuit's decision on these particular facts is thus unlikely ever to be repeated.

Alternatively, there certainly is nothing destabilizing about a holding that adheres to the plain language of a statute and the case law construing it. Petitioners' counsel conceded at oral argument before the Federal Circuit that there is no precedent directly contrary to the result reached here. None is cited in the Petition either. *In re Serenkin*, 479 F.3d 1359 (Fed. Cir. 2007), a case decided by the Federal Circuit after this one, likewise underscores that the Federal Circuit's precedents preserve a consistent

distinction between those inadvertent errors that fall within Section 251's parameters and those advertent "errors" that do not. The Federal Circuit's decision below reinforces that distinction as well.

Finally, the Manual of Patent Examining Procedure ("MPEP"), the manual that the Patent Office and Patent Examiners follow in patent prosecution procedures, provides a non-exhaustive list of errors that may be corrected by reissue in Section 1402. (Res. App. at 1-7). Included in the list are errors such as the one here, that do not involve changes to the claim language. The decision in this case is thus also in conformity with established administrative practice.

When all is said and done, therefore, no destabilization follows from the decision below as far as the controlling statute, case law, or administrative practice is concerned. What would be a marked and destabilizing departure, however, is the adoption of the radical alterations to the statutory language proposed in the Petition. Under those alterations, reissue would be eliminated for a whole class of errors falling within the statute and properly deemed correctable by the Federal Circuit and the Patent Office under current practice.

None of the criteria warranting this Court's review are present and the Petition should be denied.[1]

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[1] Petitioners invite the views of the Solicitor General, a step that is unnecessary given the Federal Circuit's adherence to Section 251's plain language, the absence of any case conflict, the conformity with administrative practice, and the uniqueness of the fact pattern involved. Simply put, the Petition presents no issue of overriding public importance to patent practice or the patent process worthy of input from the Solicitor General.

COUNTERSTATEMENT OF THE CASE

I. BACKGROUND AND SUMMARY OF THE PROCEDURAL EVENTS

This case involves a dispute over the reissue of a patent. Reissue is an important, but rarely utilized, part of the patent system. It allows an inventor to correct certain types of errors in a patent application to protect the fruits of his or her labors. To that end, 35 U.S.C. § 251 provides for reissue:

> Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent. . . .

The narrow issue implicated by the decision below is whether the unique circumstances underlying Medrad's request for reissue of U.S. Patent No. RE 37,602 ("the '602 patent"), as approved by the Patent and Trademark Office ("PTO"), meets these well-established and uncontroverted requirements. As outlined fully in the decision below, the undisputed facts reveal that these requirements are met and that reissue was warranted, just as Congress intended and the PTO concluded.

A. Medrad's Invention

The '602 patent pertains to vascular injection systems used with magnetic resonance imaging (MRI). MRI technology, introduced into clinical medical practice in the early 1980s, employs magnetic resonance (MR) scanners that utilize magnetic fields to produce high-resolution images of body tissue structure. MRI is particularly useful

for diagnosing and tracking diseases affecting the brain, central nervous system, neck, and large joints, and for detecting soft tissue disorders.

A contrast agent (a liquid pharmaceutical that enhances images) can be injected into a patient to enhance diagnostic images produced using MR scanners. An electro-mechanical device called an injector is sometimes used to inject a contrast agent into a patient. The magnetic attraction produced by MR scanners can, however, seriously disturb electronics and bring motors to a stop. At the same time, electronic components, such as might be used in an injector, produce "noise" that interferes with the MR scanner's ability to detect the faint signals that produce patient imaging.

To develop an injector for these MRI procedures, Medrad accordingly had to overcome the significant technical problems caused by the strong magnetic fields and highly sensitive signal-detection equipment. In 1996, it did so when it introduced the Spectris® injector – the first one ever offered for use in MRI procedures.

B. The History Of Medrad's Patents

The original U.S. Patent No. 5,494,036 ("the '036 patent") that covered Medrad's invention was filed on November 26, 1993, and issued on February 27, 1996. Less than two years later, Medrad requested reissue. This first reissue patent – U.S. Patent No. Re 36,648 ("the '648 reissue patent") – issued on April 11, 2000. During the examination of the '648 reissue patent, some of the claims in the original '036 patent were canceled, others narrowed based on newly considered prior art, and new claims were added that had not been in the original '036 patent.

In December 1999, while the '648 reissue patent was pending in the PTO, Petitioners' infringing Optistar MR injector system received FDA approval. Upon investigation, Medrad determined that Optistar infringed many of the claims that would be included in the '648 reissue patent when it issued. Consequently, after the '648 reissued, Medrad filed a complaint with the United States International Trade Commission ("ITC") pursuant to Section 337 of the Tariff Act of 1930. During the ITC action, Petitioners filed a Motion for Summary Determination (the ITC equivalent of a summary judgment motion) asserting the invalidity of the '648 reissue patent because of the inventors failure to file supplemental reissue declarations during examination of the patent.

Although the PTO did not request supplemental reissue declarations during the '648 reissue patent examination, Administrative Law Judge Luckern decided that (1) the patent statutes required Supplemental Declarations, (2) the PTO could not waive that requirement, and (3) the '648 reissue patent was invalid for purposes of the ITC's jurisdiction.

C. The '602 Patent

Given the adverse ruling, Medrad decided to request reissue from the PTO to correct the alleged error as determined by the ITC. Medrad provided all pertinent information it had to the PTO, including a comprehensive and detailed account of the ITC action and determination. (*See* Res. App. at 8-11). In the reissue application that resulted in the '602 patent, the inventors filed supplemental reissue declarations stating that they believed that the

prior '648 reissue patent was partly inoperative on two grounds.

First, the inventors explained that the patent was "partly inoperative for lack of a supplemental reissue declaration directed to the overclaiming error in [claims 9 and 13 of the '036 patent]." (Res. App. at 13). The inventors stated that they had believed that the "all errors" language in the original reissue declaration covered the overclaiming error, prior to the ITC ruling. (Res. App. at 13). They further stated that their omission of supplemental reissue declarations occurred "without any deceptive intention on [their] part." (Res. App. at 13).

Second, the inventors stated that they believed the '648 patent to be "partly inoperative for lack of a supplemental reissue declaration by all the inventors, in view of the initial determination" of invalidity by Judge Luckern. (Res. App. at 13-14). Thus, as part of the '602 reissue application, the inventors stated that they previously believed that their prior declarations were sufficient, and such error occurred "without any deceptive intention on [their] part." (Res. App. at 13).

Based on this two-part showing of inadvertent error, the second reissue patent – the '602 patent-in-suit – issued on March 26, 2002.

D. The Construction Of Section 251 In The District Court And On Appeal

In the underlying litigation, the parties filed summary judgment motions dealing with whether Medrad's '602 reissue patent fell within the scope of 35 U.S.C. § 251. The district court granted Petitioners' motion, dismissed

Medrad's claims, and held the '602 patent invalid on the ground that Section 251 purportedly "requires that some error in the specification, drawings, or claims of the patent be corrected as a result of the reissue process." *Medrad, Inc. v. Tyco Healthcare Group, LP*, 391 F. Supp.2d 374, 378 (W.D. Pa. 2005).

On appeal, the Federal Circuit reversed and held that a basis for reissue existed because the error that Medrad sought to correct arose "by reason of . . . the patentee claiming more or less than he had a right to claim in the patent" as required by Section 251. (Pet. App. A at 8a-10a). The Federal Circuit's decision rests on a thorough analysis of the discrete facts in this controversy, as applied to Section 251's express language. (Pet. App. A at 5a-7a). Specifically, the Federal Circuit found that:

> by including changes to the language of the claims that narrowed the scope of coverage and by correcting inventorship, the resulting '648 reissue patent claimed more than it had a right to claim in the patent without submitting a supplemental declaration to support the narrowing subject matter and the change in inventorship. The correction of such an error meets the express terms of Section 251, and thus serves as a basis for reissue.

(Pet. App. A at 10a).

Petitioners' Petition for Rehearing En Banc, raising the same unfounded construction and conflict issues presented to this Court, was denied.

REASONS FOR DENYING THE PETITION

II. THE FEDERAL CIRCUIT FOLLOWED SECTION 251'S EXPRESS LANGUAGE AND ESTABLISHED PRECEDENT IN UPHOLDING THE REISSUE OF THE '602 PATENT

A. The Federal Circuit's Decision Properly Interprets The Express Limitations Of The Reissue Statute In Accord With Controlling Principles Of Statutory Interpretation

The Federal Circuit's decision appropriately interprets the express limitations of 35 U.S.C. § 251, namely its provision that:

> Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent. . . .

As the plain language of the statute provides, errors correctable under Section 251 must meet only three basic prerequisites:

(1) the error must have been made without deceptive intention;

(2) the error must result in the patent being deemed wholly or partly invalid or inoperative; and

(3) the invalidity or inoperability must occur "by reason of" a defective specification or drawing or the patentee claiming more or less than it had a right to claim in the patent.

The statute thereby encompasses errors in law, errors in drafting, errors of substance, procedural errors, attorney errors, inventor errors or any other type of inadvertent error that gives rise to the need for correction. *See, e.g., Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1574-75 (Fed. Cir. 1991) (reissue statute extends to errors of law and attorney errors that meet the statutory requirements). Any attempt to read the statute more narrowly is not faithful to its plain language or Congress's policy choice in defining the statute's remedial scope. *See In re Weiler*, 790 F.2d 1576, 1579 (Fed. Cir. 1986) ("in enacting the statute, Congress provided a statutory basis for correction of 'error.' The statute is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally.").

Given the statute's actual requirements, there is nothing controversial about the Federal Circuit's reasoning upholding the PTO's allowance of the '602 reissue patent. The particular error corrected was held to meet the statute's express terms because it was inadvertent, rendered the '648 reissue patent invalid, and arose by reason of Medrad "claiming more than it had a right to claim in the ['648 reissue] patent." (Pet. App. A at 10a). None of these facts are disputed and Section 251's plain language directly supports the Federal Circuit's holding.

As a result, Petitioners' contention that the decision below renders "superfluous" the express limitations of Section 251 (Pet. at 9-10), does not withstand analysis. It is unclear how the Federal Circuit could render "superfluous" a phrase that it actually interpreted and then determined was met by the particular facts of this case. (Pet. App. A at 7a-8a, 10a). Petitioners nevertheless claim that the Federal Circuit's construction nullifies the Section's

requirement that the error correction must involve an actual change in the claims, specification, or drawings. (Pet. at 1-2, 10-11, 13). But that limiting language does not appear anywhere in the statute itself. Nor does Petitioners' companion "procedural" versus "non-procedural" distinction, the former purportedly falling outside Section 251, and the latter within it. All these supposed requirements are the product of Petitioners' editing, not Congressional directive.

Thus, it is Petitioners who are violating this Court's precedent by reading language and limitations into a statute that Congress did not provide for. If Congress had intended any of the limitations that Petitioners seek to include, it would have expressly included such limitations. *See Barnhart v. Sigmon Coal Co., Inc.*, 534 U.S. 438, 454, 461-62 (2002). As this Court has stated "time and again":

> "[C]ourts must presume that a legislature says in a Statute what it means and means in a Statute what it says there. When the words of the Statute are unambiguous, then this first canon is also the last: 'judicial inquiry is complete.'"

Id. at 461-62 (citations omitted). By adhering to Section 251's plain language and rejecting Petitioners' efforts to read limitations into the section that Congress did not see fit to provide, the Federal Circuit reached a result in accord with this Court's precedent. (Pet. App. A at 6a-8a). A court's adherence to a statute's plain language provides no occasion for this Court's review.

B. The Federal Circuit's Interpretation Of The Limitation "By Reason Of The Patentee Claiming More Or Less Than He Had A Right To Claim" Creates Not Even An Arguable Conflict With Existing Federal Circuit Or CCPA Precedent

The Federal Circuit's construction of the phrase "by reason of the patentee claiming more or less than he had a right to claim" does not conflict with any prior holding of the Federal Circuit or the Court of Custom and Patent Appeals ("CCPA"). Rather, the Federal Circuit's construction is consistent with the decisions of that court, the CCPA and other federal courts of appeal, which have allowed patents to be reissued without a change in the actual claim language. The Federal Circuit's refusal to consider this case *en banc* further confirms that there is no conflict within Federal Circuit law on this point.

For example, in *Fontijn v. Okamoto*, 518 F.2d 610, 622 (C.C.P.A. 1975), the CCPA compared and distinguished the "by reason of the patentee claiming more or less" language in the first paragraph of Section 251 (the language at issue here), with the phrase "scope of the claims" in the last paragraph of Section 251.[2] *Id.* at 622-23. In its comparison and analysis, the CCPA confirmed that "claiming more or less" includes errors that do not involve actual changes to the words of the claims. *Id.* In contrast, the passage "enlarging the scope of the claims" (not at issue in the

[2] In *Fontijn*, the CCPA made this comparison to determine the meaning of the language in the last paragraph of Section 251 – "enlarging the scope of the claims" – which relates to the requirement that reissue must be applied for within two years of the issue date of the underlying patent if the actual claim language is broadened.

present case) was found to have a different meaning limited to the wording of the patent claims themselves. *Id.*

To the same effect, in *Brenner v. State of Israel*, 400 F.2d 789, 791 (D.C. Cir. 1968), the D.C. Circuit[3] held that the error of failing to file a certified copy of the foreign application upon which the inventor sought priority, an error that did not occur in the actual language of the claims, was correctable under Section 251 "by reason of the patentee claiming more or less than he had a right to claim." The court succinctly summarized how the failure to file the certified copy fit squarely within the statute:

> The plain meaning of this section would seem to cover this situation. The patent issued was partly inoperative (insofar as it did not include the priority right), and the patentee . . . did claim less than he had a right to claim.

Brenner, 400 F.2d at 791.

By parity of reasoning, in the Federal Circuit's *en banc* decision in *In re Bennett*, 766 F.2d 524 (Fed. Cir. 1985), a patentee's failure to file a correct reissue declaration in a timely manner was allowed to be corrected by the filing of a supplemental reissue declaration. *Id.* at 528. Although the corrected declaration was filed during the pendency of the reissue rather than in a new reissue application as was done in the present case, the *Bennett* decision underscores that "an error in compliance with Section 251" can be corrected in keeping with the remedial nature of the statute. *Id.* As the Federal Circuit noted,

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[3] The CCPA adopted and applied the holding of *Brenner* in *Fontijn*, 518 F.2d at 622-23, and the Federal Circuit expressly endorsed the holdings of *Brenner* and *Fontijn* in *Serenkin*, 479 F.3d at 1364.

"[t]he purpose of the reissue statute is to remedy errors." *Id.*[4]

Most recently, in *In re Serenkin*, a case decided after the decision below, the Federal Circuit expressly endorsed the holdings in *Brenner* and *Fontijn*, thereby confirming that a change in the claim's language, drawings or specifications is not a prerequisite to a valid reissue. On the contrary, the court pointed out that "the errors in those cases were the result of inadvertence, accident, or mistake, which clearly are appropriate bases for reissue." 479 F.3d at 1364.

By allowing the correction of an inadvertent error that indisputably resulted in a patentee claiming "more or less that it had a right to claim," the Federal Circuit's decision to uphold the reissue in this case faithfully adheres to the language of Section 251 and gives the statute its intended scope. It also aligns with existing precedent, like *Fontijn*, *Brenner*, *Bennett*, and *Serenkin*, construing the statute's plain terms as Congress intended.

In contrast, none of the cases cited by Petitioners hold that Section 251's "by reason of the patentee claiming more or less than he had a right to claim" is inapplicable to an inadvertent error that requires the filing of a second reissue patent with a supplemental reissue declaration. Indeed, the vast bulk of the cases cited either do not implicate the kind of inadvertent error at issue in this case

[4] The interpretation of Section 251 and the holding in this case is consistent with the interpretation of Section 251 and the holdings in *Fontijn, Brenner,* and *Bennett*. While the Federal Circuit distinguished the facts of those cases from the present case, their treatment of Section 251 is consistent with the Federal Circuit's holding below. (*See* Pet. App. A at 6a-6b).

or do not involve a construction of the language in Section 251 actually at issue. For those that do construe the relevant language, moreover, there is no even arguable conflict with the result reached.

For example, in *In re Serenkin*, the patent owner's attorney made the deliberate decision of choosing a later filing date during prosecution in exchange for including missing drawings. 479 F.3d at 1362-63. The patent owner subsequently filed a reissue application asking for an earlier filing date, claiming the attorney's deliberate choice was an error. In determining that reissue was not available to undo the deliberate decision to claim a later filing date, the Federal Circuit stated:

> Our case law holds that the deliberate action of an inventor or attorney during prosecution generally fails to qualify as a correctable error under § 251.

Id. at 1362.[5]

Similarly, in *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 882 F.2d 1556, 1566 (Fed. Cir. 1989), the applicant sought to add new claims via reissue, but again did not establish that the change in the claims was an "error without deceptive intent." *Id.* at 1565-66. The Federal Circuit acknowledged in dicta that precedent supports the notion that the "claiming more or less" language of Section

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[5] *In re Weiler* is similar. There the patent owner sought to pursue broadened claims on reissue, claims that the patent owner deliberately did not pursue (by filing a divisional application) during prosecution. 720 F.2d at 1582-83. The Federal Circuit thus held that the patent owner had not made an inadvertent error as Section 251 requires, but a deliberate choice. *Id.*

251 "*generally* refers to the scope of the claim." *Id.* at 1564 (emphasis added). The Federal Circuit did not hold, however, that the "claiming more or less language" *only* referred to the scope of the claim as Petitioners argue.

By comparison, in *In re Handel*, 312 F.2d 943 (C.C.P.A. 1963), the issue was whether claims that were actually amended during reissue were for the same "invention disclosed in the original patent" as required by Section 251, but the court did not analyze the portion of Section 251 at issue here.[6] 312 F.2d at 948. The CCPA reversed the Patent Office Board of Appeals decision to reject the reissue because the Board looked only to the claims rather than the entire disclosure of the patent to determine whether the new claims were directed at the same invention as in the original patent. *Id.* at 948-49.

And, in *In re Rogoff*, 261 F.2d 601 (C.C.P.A. 1958), the applicant's attempt to add new claims during reissue was rejected because the new claims were broader than the original claims and filed too late in violation of the last paragraph of Section 251, which prohibits broadening reissue applications that are filed more than two years after grant of an original patent. *Id.* at 604-06. The CCPA only addressed the portion of Section 251 at issue here in rejecting the applicant's alternative argument that the new claims being added were of the same scope as, and not

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[6] *In re Amos*, 953 F.2d 613 (Fed. Cir. 1991) is to the same effect. There, the applicant also sought to add new claims via reissue, but the reissue was rejected because the applicant had not demonstrated it had an "intent to claim" the subject matter of the new claims in the original patent disclosure. *Id.* at 619. The Federal Circuit only set forth the "claiming more or less" language in Section 251 in the general way quoted by Petitioners but did not analyze or apply the language because it was not at issue in that case. *Id.* at 616.

broader than, the original claims. *Id.* at 605-06. The CCPA noted that the new claims were not of the same scope and even if they were, the statute provides no basis to merely add new claims of the same scope as the original claims.[7] 261 F.2d at 605-06.

Finally, and to like effect, in *In re Dien*, 680 F.2d 151 (C.C.P.A. 1982), the applicant never alleged there was a defect in the patent or that the patent was invalid in whole or in part, but merely sought reissue of a patent having the same claims, specification and drawings over some prior art that was not submitted to the Patent Office. *Id.* at 152. "In other words, no defect in the patent is alleged nor is any change in the patent sought." *Id.*

Here, in contrast, Medrad alleged and corrected an inadvertent error in the '648 reissue patent, failing to file a supplemental declaration, acknowledged by both the ITC and the Federal Circuit. The '602 reissue patent thus was not in identical form to the '648 patent, as the CCPA in *In re Dien* would define it, because that request for reissue specifically corrected the error of the lack of a

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[7] In *Slip Track Sys., Inc. v. Metal Lite, Inc.*, 159 F.3d 1337 (Fed. Cir. 1998), there was no reissue patent at all. Rather, the Federal Circuit indicated that a reissue patent was not an option available to a patent owner who sought to litigate priority between two patents. *Id.* at 1341. Reissue was not available because the patent owner did not allege there was an error in the patent, but rather, alleged that the Patent Office erred in issuing another patent for the same invention. *Id.* The Federal Circuit thus cited a previous holding that a reissue application may not be filed "solely on the ground that the PTO erred in issuing two patents for the same invention." *Id.* The passage cited by Petitioners is a cursory general description of the statute that was not further analyzed or applied.

supplemental declaration.[8] And, unlike in *In re Dien* and Petitioners' other cited cases, the error corrected in this case satisfies Section 251's actual terms.

In sum, far from creating a conflict with the decision below, Petitioners' string of cases simply highlights that the Federal Circuit comprehends when Section 251 applies and when it does not. That guidance is sufficient for the bench, bar, and PTO alike and creates no reason for this Court to intervene. This is particularly true given the uniqueness of this case and the rarity of reissue. None of the cases cited by Petitioners involve the same facts that are present in this case, and only 40,000 of the 7 million patents issued by the PTO have ever been reissued. Moreover, established PTO practice, as evidenced by the Section 1402 of the MPEP (Res. App. at 1-7), allows for the correction of errors in reissue such as the one here, that do not involve changes to the claim or specification language or the drawings. For example, the MPEP indicates that one of the "most common bases for filing a reissue application" is that the applicant "failed to or incorrectly claimed foreign priority" and approvingly cites *Brenner* and *Fontijn* as examples. (Res. App. at 2, 3-4). The infrequency of reissue, coupled with the lack of a conflict in the case law, and established administrative practice dictates that this

[8] Likewise, in *In re Clement*, 131 F.3d 1464 (Fed. Cir. 1997), reissue was rejected because the new claims sought to be added would improperly recapture subject matter that had been surrendered during prosecution. *Id.* at 1472. Since no error was alleged in, and no change was made to, the original claims (1-18), they could not support reissue either. *Id.* It was these original claims, lacking error or changes, that the Federal Circuit was referring to when it cited the "identical form" statement from *In re Dien*. *Id.*

case does not present a significant or reoccurring issue warranting this Court's attention.

CONCLUSION

The decision below addresses a unique set of facts utilizing a rare procedure, follows the express language of Section 251, and is in accord with controlling precedent and PTO practice. This Court should deny the petition for writ of certiorari.

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United States Patent and Trademark Office

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1402 Grounds for Filing [R-5]

A reissue application is filed to correct an error in the patent which was made without any deceptive intention, where, as a result of the error, the patent is deemed wholly or partly inoperative or invalid. An error in the patent arises out of an error in conduct which was made in the preparation and/or prosecution of the application which became the patent.

There must be at least one error in the patent to provide grounds for reissue of the patent. If there is no error in the patent, the patent will not be reissued. The present section provides a discussion of what may be considered an error in the patent upon which to base a reissue application.

In accordance with 35 U.S.C. 251, the error upon which a reissue is based must be one which causes the patent to be "deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent." Thus, an error under

35 U.S.C. 251 *has not been presented* where the correction to the patent is one of spelling, or grammar, or a typographical, editorial or clerical error which does not cause the patent to be deemed wholly or partly inoperative or invalid for the reasons specified in 35 U.S.C. 251. These corrections to a patent do not provide a basis for reissue (although these corrections may also be included in a reissue application, where a 35 U.S.C. 251 error is already present).

These corrections may be made via a certificate of correction; see MPEP § 1481.

The most common bases for filing a reissue application are:

(A) the claims are too narrow or too broad;

(B) the disclosure contains inaccuracies;

(C) applicant failed to or incorrectly claimed foreign priority; and

(D) applicant failed to make reference to or incorrectly made reference to prior copending applications.

An attorney's failure to appreciate the full scope of the invention was held to be an error correctable through reissue in the decision of *In re Wilder,* 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984). The correction of misjoinder of inventors in divisional reissues has been held to be a ground for reissue. See *Ex parte Scudder,* 169 USPQ 814 (Bd. App. 1971). The Board of Appeals held in *Ex parte Scudder,* 169 USPQ at 815, that 35 U.S.C. 251 authorizes reissue application to correct misjoinder of inventors where 35 U.S.C. 256 is inadequate.

Reissue may no longer be necessary under the facts in *Ex parte Scudder, supra,* in view of 35 U.S.C. 116 which provides, *inter alia,* that:

> "Inventors may apply for a patent jointly even though . . . (3) each did not make a contribution to the subject matter of every claim in the patent"

See also 37 CFR 1.45(b)(3).

If the only change being made in the patent is correction of the inventorship, this can be accomplished by filing a request for a certificate of correction under the provisions of 35 U.S.C. 256 and 37 CFR 1.324. See MPEP § 1412.04 and § 1481. A Certificate of Correction will be issued if all parties are in agreement and the inventorship issue is not contested.

A reissue was granted in *Brenner v. State of Israel,* 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968), where [1402] the only ground urged was failure to file a certified copy of the original foreign application to obtain the right of foreign priority under 35 U.S.C. 119(a)-(d) before the patent was granted.

In *Brenner,* the claim for priority had been made in the prosecution of the original patent, and it was only necessary to submit a certified copy of the priority document in the reissue application to perfect priority. Reissue is also available to convert the "error" in failing to take any steps to obtain the right of foreign priority under 35 U.S.C. 119(a)-(d) before the patent was granted. >See *Fontijn v. Okamoto,* 518 F.2d 610, 622, 186 USPQ 97, 106 (CCPA 1975) ("a patent may be reissued for the purpose of establishing a claim to priority which was not asserted, or which was not perfected during the prosecution of the

original application")< In a situation where it is necessary to submit for the first time both the claim for priority and the certified copy of the priority document in the reissue application, and the patent to be reissued resulted from a utility or plant application which became the patent to be reissued was filed on or after November 29, 2000, the reissue applicant must (where it is necessary to submit for the first time the claim for priority) also file a petition for an unintentionally delayed priority claim under 37 CFR 1.55(c) in addition to filing a reissue application. See MPEP § 201.14(a).

The courts have not addressed the question of correction of the failure to adequately claim benefit under 35 U.S.C. 119(e) in the application (which became the patent to be reissued) via reissue. If the application which became the patent to be reissued was filed prior to November 29, 2000, correction as to benefit under 35 U.S.C. 119(e) would be permitted in a manner somewhat analogous to that of the priority correction discussed above. **>Where< the application, which became the patent to be reissued, was filed on or after November 29, 2000>, reissue may be employed to correct an applicant's mistake by adding or correcting a benefit claim under 35 U.S.C. 119(e). A petition under 37 CFR 1.78(a)(6) for an unintentionally delayed claim under 35 U.S.C. 119(e) would *not* be required in addition to filing a reissue application.<.

Section 4503 of the American Inventors Protection Act of 1999 (AIPA) amended 35 U.S.C. 119(e)(1) to state that:

> No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such

> time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section ***during the pendency of the application.*** (Emphasis added.)

**>The court in *Fontijn* held that 35 U.S.C. 251 was sufficiently broad to correct a patent where the applicant failed to assert or failed to perfect a claim for foreign priority during the prosecution of the original application even though 35 U.S.C. 119(b) at that time required a claim and a certified copy of the foreign application to be filed *before the patent is granted.* Similarly, the Office may grant a reissue for adding or correcting a benefit claim under 35 U.S.C.119(e) that requires the benefit claim to a provisional application be submitted *during the pendency of the application.*<.

Correction of failure to adequately claim benefit under 35 U.S.C. 120 in an earlier filed copending U.S. patent application was held a proper ground for reissue. *Sampson v. Comm'r Pat.,* 195 USPQ 136, 137 (D.D.C. 1976). If the utility or plant application which became the patent to be reissued was filed on or after November 29, 2000, the reissue applicant must file a petition for an unintentionally delayed priority claim under 37 CFR 1.78(a)(3) in addition to filing a reissue application. See MPEP § 201.11. For treatment of an error involving disclaimer of a benefit claim under 35 U.S.C. 120, see MPEP 1405. If the utility or plant application which became the patent to be reissued was filed prior to November 29, 2000 and

therefore, not subject to the eighteen-month publication (e.g., one of the categories set forth in 37 CFR 1.78(a)(2)(ii)(A)-(C)), a petition for an unintentionally delayed benefit claim under 37 CFR 1.78(a)(3) would *not* be required to add/correct the benefit claim in the reissue application. This is so, even if the reissue application was filed on or after November 29, 2000. On the other hand, if applicant fails to file an amendment to add a claim for benefit of a prior-filed reissue application in a later-filed reissue application within the time period set forth in 37 CFR 1.78(a)(2), then a petition for an unintentionally delayed benefit [1403] claim under 37 CFR 1.78(a)(3) along with the surcharge set forth in 37 CFR 1.17(t) would be required if the later-filed reissue application is a utility or plant application filed on or after November 29, 2000 irrespective of whether the original application which became the original patent was filed prior to November 29, 2000. This is because the benefit claim is between the later-filed reissue application and the prior-filed reissue application and the benefit claim is not being added to make a correction as to a benefit of the original patent.

A reissue applicant's failure to timely file a divisional application covering the non-elected invention(s) following a restriction requirement is not considered to be error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. Thus, such applicant's error is not correctable by reissue of the original patent under 35 U.S.C. 251. See MPEP § 1412.01.

A reissue may be based on a drawing correction that is substantive in nature, because such a correction qualifies as correcting an "error" under 35 U.S.C. 251 that may properly be deemed to render the patent wholly or partly

inoperative. A reissue application cannot be based on a non-substantive drawing change, such as a reference numeral correction or addition, the addition of shading, or even the addition of an additional figure merely to "clarify" the disclosure. Non-substantive drawing changes may, however, be included in a reissue application that corrects at least one substantive "error" under 35 U.S.C. 251.

* * *

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Patent

Application of U.S. Patent No. Re. 36,648:

Uber, III et al.	: Group Art Unit: 3737
Appln. No.: 09/714,907	: Examiner: B. Casler
Filed: November 16, 2000	:

Title: PATIENT INFUSION SYSTEM FOR USE WITH MRI

* * * * *

June 8, 2001

INFORMATION DISCLOSURE STATEMENT

Hon. Commissioner
of Patents and Trademarks
Washington, D.C. 20231

Sir:

This IDS contains two parts. For the first part, the Applicant submits seven (7) sheets (forms PTO-1449) listing a number of references that the Applicant asks the Examiner to consider. For the second part, the Applicant details specific facts (prior to and after the filing of the patent application on which this application is based) concerning certain activities by the assignee of this application, Medrad, Inc., that the Applicant would like the Examiner to consider pursuant to the provisions of the "on-sale" bar codified at 35 U.S.C. § 102(b).

II. Factual Information for the Examiner's Consideration Under the "On-Sale" Bar Codified by 35 U.S.C. § 102(b)

A. Summary of the History of This Application and Related Applications

1. The application that matured into U.S. Patent No. 5,494,036 (Exhibit 1) ("the '036 patent") was filed on November 26, 1993, and bore Serial Number 08/158,055 ("the '055 application"). The '036 patent issued on February 27, 1996. (Exhibit 1.)

2. By the assignment recorded at the U.S. Patent and Trademark Office on February 14, 1994, at Reel 6897, Frame 0942, Medrad, Inc. is the assignee of the '036 patent.

3. On February 23, 1998, within two years of the issue date of the '036 patent, the Applicant filed an application to reissue the '036 patent. (Exhibit 2.) That application bore Serial Number 09/027,852 ("the '852 application") and ultimately matured into U.S. Patent No. Re. 36,648 (Exhibit 2) ("the '648 patent").

4. By reissue, the Applicant sought to broaden the scope of protection for the invention because the Applicant believed that the '036 patent was inoperative for claiming less than the Applicant originally had the right to claim. (*See* the Reissue Declaration filed in the '852 application, attached as Exhibit 3.) The '852 application issued as the '648 patent on April 11, 2000. (Exhibit 2.)

5. To more fully claim the invention described in the '852 application, the Applicant filed a continuation on April 7, 2000, just prior to the issuance of the '648 patent. The continuation reissue application bears serial number 09/545,582 ("the '582 application") and is currently pending.

6. After issue of the '648 patent (Exhibit 2), Assignee, Medrad, Inc., initiated an investigation by the International Trade Commission ("ITC") against several defendants, alleging, *inter alia*:, infringement of certain claims of the '648 patent by the named defendants.

7. The ITC commenced the investigation, entitled *In the Matter of: Certain Magnetic Resonance Injection Systems, Components Thereof, and Molds Therefor* (Investigation No. 337-TA-434).

8. On September 26, 2000, Administrative Judge Paul J. Luckern issued Order No. 16 in which he determined that the '648 patent was invalid under 37 C.F.R. § 1.175(b)(1) for lack of a supplemental reissue declaration directed to the overclaiming and inventorship errors corrected thereby.

9. Since the '648 patent was found to be invalid, the ITC terminated its investigation.

10. To correct the "error" in the '648 patent" identified by Judge Lucken in his September, 2000 decision, the Applicant filed an application to reissue the '648 patent. (Exhibit 4, which is a copy of the Reissue Declaration therefor.)

11. The reissue application of the '648 patent was filed on November 16, 2000 and bears Serial Number 09/714,907 ("the '907 application"). The '907 application is the instant application.

12. In view of this history, the Applicant points out that there are now two applications currently pending that relate to the underlying '036 patent, the continuation of the original reissue application (which is the '582 application) and the reissue of the '648 reissue patent (which is the '907 application) introduced publicly. Accordingly, the mere development of the basic concept

requirements of the MR injector in April and July of 1992, with the absence of design particulars, indicates that the invention was not ready for patenting at that time.

III. Conclusion

104. The facts and the law both support the conclusion that the activities of Medrad, Inc. more than one year before the filing of the '055 application fail to render the claims of this application unpatentable under 35 U.S.C. § 102(b). In the aggregate, the facts simply do not rise to a sufficient level to trigger application of the "on-sale" bar under 35 U.S.C. § 102(b).

Consideration of the foregoing and enclosures plus the return of a copy of the enclosed forms PTO-1449 with the Examiner's initials in the left column per MPEP 609 are earnestly solicited.

Respectfully submitted,
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IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE

In re Reissue Application of:	)	
UBER et al.	)	
	)	Art Unit: 3737
U.S. Reissue Patent No.: 36,648	)	
Issued: April 11, 2000	)	
	)	Examiner:
Filed: February 23, 1998	)	Brian L. Casler
For: PATIENT INFUSION SYSTEM FOR USE WITH MRI	)	

REISSUE DECLARATION

Assistant Commissioner
for Patents
Box Reissue
Washington, D.C. 20231

Dear Sir:.

We, Arthur B. Uber, III, Seid Waddell, John Stulen, Jon E. Manley, Salvatore J. Dedola and Gordon C. Newell hereby declare that: our residences, post office addresses and citizenship are as stated below next to our names; we believe that we are the original, first and sole inventors of the subject matter described and claimed in U.S. Patent No. RE 36,648, granted on April 11, 2000, and for which a reissue patent is sought on the invention entitled "Patient Infusion System For Use With MRI," the specification of which is attached hereto; we have reviewed and understand the contents of the above-identified reissue application, including the claims therein; we acknowledge the duty to disclose information which is material to patentability as defined in Title 37. Code of Federal Regulations, Section 1.56; for the reasons provided below, we each

verily believe the original reissue patent to be partly inoperative; and all errors specified herein and corrected in this reissue application arose without any deceptive intention on our part.

Administrative Law Judge Paul J. Luckern of the U.S. International Trade Commission ("ITC") issued Order No. 16, in ITC Investigation No. 337-TA-434, on September 26, 2000 (hereinafter "Order No. 16") (a copy of which is submitted herewith). Specifically, Order No. 16 is an initial determination that the original reissue patent is invalid under 37 C.F.R. § 1.175(b)(1) for lack of a supplemental reissue declaration directed to the overclaiming and inventorship errors that were corrected in U.S. Patent No. RE 36,648.

We believe U.S. Patent No. RE 36,648 to be partly inoperative for lack of a supplemental reissue declaration directed to overclaiming in the original patent, U.S. Patent No. 5,494,036, which rendered that patent partly inoperative by reason of our claiming more than we had a right to claim in the patent. Specifically, we had claimed more than we had a right to claim in paragraph (d) of each of claims 9 and 13, by failing to recite the "communicating link" as a "communicating control link". Although we believed and intended that the language "all errors" in our reissue declaration included the overclaiming as well as the specifically recited underclaiming, Administrative Law Judge Paul J. Luckern disagreed, in Order No. 16, and found U.S. Patent No. RE 36,648 invalid because we failed to specifically recite this overclaiming error in the reissue declaration.

We also believe U.S. Patent No. RE 36,648 to be partly inoperative for lack of a supplemental reissue declaration

by all the inventors, in view of the initial determination by Administrative Law Judge Paul J. Luckern in Order No. 16. We, the named inventors, are each declarants herein and we each declare that we have no disagreement with the inventorship change in U.S. Patent No. RE 36,648. This declaration supplements the reissue declarations made in the application that resulted in U.S. Patent No. RE 36,648, which reissue declarations were previously believed to have been sufficient under the revised reissue rules.

We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issued thereon, or any patent to which this Reissue Declaration is directed.

Full Name of Joint Inventor:	Arthur E. Uber, III
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Full Name of Joint Inventor: John Stulen

Inventor's Signature: _____ Date: _____
Residence: Pittsburgh, Pennsylvania
Citizenship: USA
Post Office Address: 260 Crestmont Road
Pittsburgh, Pennsylvania
15237

We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issued thereon, or any patent to which this Reissue Declaration is directed.

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15237

We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issued thereon, or any patent to which this Reissue Declaration is directed.

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Full Name of Joint Inventor: Gordon C. Newell

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Full Name of Joint Inventor:	Salvatore J. Dedola
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(3)

FILED
JUN 18 2007
OFFICE OF THE CLERK
SUPREME COURT, U.S.

No. 06-1328

IN THE
Supreme Court of the United States

TYCO HEALTHCARE GROUP LP,
MALLINCKRODT INC., LIEBEL-FLARSHEIM COMPANY,
AND NEMOTO KYORINDO CO., LTD.

Petitioners,

v.

MEDRAD, INC.,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

REPLY TO BRIEF IN OPPOSITION

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June 18, 2007

WILSON-EPES PRINTING CO., INC. – (202) 789-0096 – WASHINGTON, D. C. 20002

Medrad acknowledges, as it must, that the patent reissue statute authorizes reissuance *only* where the original patent is invalidated either "'[1] by reason of a defective specification or drawing, or [2] by reason of the patentee claiming more or less than he had a right to claim in the patent.'" Opp. 9 (quoting 35 U.S.C. § 251). Medrad further acknowledges that its '648 patent was invalidated for failure to file a supplemental declaration during the examination process. Opp. 6-7. The key issue, therefore, is whether the failure to file a supplemental declaration satisfies one of the statutory requirements for reissuing a patent, namely "claiming more or less than [the patentee] had the right to claim," so that Medrad had a right to reissuance under § 251. The answer to that question, as explained in the Petition, is clearly "no."[1]

Medrad argues, as it must, that the Federal Circuit correctly answered that question in the affirmative, and did not thereby render superfluous the express language of the reissue statute. Opp. 10. Medrad is demonstrably wrong. The Federal Circuit held that "the resulting '648 reissue patent claimed more than it had a right to claim in the patent without submitting a supplemental declaration." Pet. App. 10a. But that just means that the patentee of an invalid patent *always* "claim[s] more ... than he had a right to claim in the patent," because by definition the patentee of an invalid patent does not have the right to claim *any* patent rights. If that were true, then *any* invalid patent could be reissued (at least as long as the invalidity was unintentional), and the italicized statutory language below is meaningless:

---

[1] Medrad remarkably asserts that it is *undisputed* that the '648 reissue patent was defective because of Medrad "claiming more than it had a right to claim in the ['648 reissue] patent." Opp. 10, 14. That issue, of course, is the very heart of the dispute.

> Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, *by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent*, the Director shall ... reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

35 U.S.C. § 251 (emphasis added). That approach violates the bedrock canon that statutes should be construed so that "no clause, sentence or word shall be superfluous, void, or insignificant." Pet. 8 (internal quotation omitted; citing cases).

Medrad fails to come to grips with this point; rather, Medrad simply insists that the Federal Circuit could not have rendered the italicized language superfluous because the Federal Circuit purported to interpret that language. Opp. 10-11. But the Federal Circuit "interpreted" the italicized language out of existence. Tellingly, neither Medrad nor the Federal Circuit has suggested any scenario under which that language limits the power to reissue an invalid patent.

Medrad's approach, moreover, not only violates the plain language of the statute, but also overturns settled expectations in light of longstanding judicial interpretation of the statute. Indeed, Medrad's discussion of the cases cited by Petitioners, and Medrad's citation of additional cases, highlights—rather than disproves—the existence of conflicting precedent regarding the interpretation of Section 251's "claiming more or less than he had the right to claim" language. The following cases, as detailed in the Petition, support a appropriate reading of this language:

- *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 882 F.2d 1556 (Fed. Cir. 1989)
- *In re Amos*, 953 F.2d 613 (Fed. Cir. 1991)
- *In re Handel*, 312 F.2d 943 (C.C.P.A. 1963)
- *In re Rogoff*, 261 F.2d 601 (C.C.P.A. 1958)
- *Slip Track Sys., Inc. v. Metal Lite, Inc.*, 159 F.3d 1337 (Fed. Cir. 1998)

Medrad attempts to distinguish these cases based on their facts, but Medrad cannot escape the fact that all of these cases take a narrow approach to the "claiming more or less" language, and do not interpret that language (as the Federal Circuit did below) to encompass *any* defect that leads to invalidity.

On the other hand, the following cases cited by Medrad, which are factually distinguishable from this case, support a broader view:

- *Fontjin v. Okamoto*, 518 F.2d 610, 622 (C.C.P.A. 1975) (stating in dicta that "claiming more or less than he had a right to claim in the patent" is not limited to the claims defining the invention)
- *Brenner v. State of Israel*, 400 F.2d 789, 791 (D.C. Cir. 1968) (holding that the failure to file a certified copy of a foreign patent, necessary to perfect a priority "claim," resulted in the "patentee claim[ing] less than he had the right to claim.")[2]

---

[2] Contrary to Medrad's contention, the CCPA did not adopt *this* holding of *Brenner* in *Fontjin*; rather, the CCPA cited a *different* holding. In addition, the Federal Circuit did not "expressly endorse[]" the holding of Brenner in *In re Serenkin*, 479 F.3d 1359 (Fed. Cir. 2007), as Medrad asserts.

Moreover, no case cited by Medrad goes nearly as far as the Federal Circuit's holding in this case. As indicated above and detailed in the Petition, the reasoning behind the Federal Circuit's broad holding would permit reissue for *any* defect that rendered a patent wholly or partly inoperative or invalid. Such an approach would open up nearly every patent for reissuance. Medrad's argument that reissue is relatively rare misses the mark. Although fewer than 1% of all issued patents have been reissued, the Federal Circuit's decision has the potential to dramatically increase this percentage, piling additional work on an already overtaxed Patent and Trademark Office.

In another remarkable statement, Medrad contends that the '602 reissue patent is "not in identical form to the '648 patent." Yet Medrad does not dispute that it made no changes to the specification, drawings, claims, or any other part of the '648 reissue patent in obtaining the '602 reissue patent. As stated in the Manual of Patent Examining Procedure ("MPEP"), the relevant portion of which Medrad included in its Appendix, "There must be at least one error *in the patent* to provide grounds for reissue of the patent. If there is no error *in the patent*, the patent will not be reissued." Opp. App. 1 (emphasis added). The MPEP then provides a "discussion of what may be considered an error in the patent upon which to base a reissue application." Opp. App. 1. All of the errors listed in the relevant MPEP section—*i.e.*, that the claims are too narrow or too broad, that the disclosure contains inaccuracies, that the applicant failed to or incorrectly claimed foreign priority, and that the applicant failed to make reference to or incorrectly made reference to prior copending applications, Opp. App. 2-3—are errors *in the patent*. The failure to file a supplemental declaration during prosecution of the patent, on the other hand, is *not* an error *in the patent*, and Medrad cites no MPEP provision or case to the contrary.

The principle of finality is important in patent law, just as in other areas of law. Thus, Congress only authorized patent reissuance for specified defects, not for any reason or as a matter of course. Because the Federal Circuit has effectively overruled Congress' policy decision, and no other judicial avenue to correct that error exists in light of the Federal Circuit's exclusive jurisdiction over patent appeals, this Court should grant the petition.

CONCLUSION

For the foregoing reasons, as well as those set forth in the petition, this Court should grant the petition, and either set the case for plenary review or summarily reverse the decision below.

Respectfully submitted,

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